

AUG 17 1945

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IN THE  
**SUPREME COURT OF THE UNITED STATES**  
OCTOBER TERM, 1944

NO. 330

JAMES W. WABER,

*Petitioner,*

*vs.*

MONTGOMERY WARD & CO., INCORPORATED,  
AND UNITED STATES RUBBER COMPANY,  
*Respondents.*

**PETITION FOR THE WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS FOR  
THE SEVENTH CIRCUIT WITH AFFIDAVIT AND  
BRIEF IN SUPPORT THEREOF.**

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IN THE  
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JAMES W. WABER,

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MONTGOMERY WARD & CO., INCORPORATED,  
AND UNITED STATES RUBBER COMPANY,

*Respondents.*

---

**PETITION FOR THE WRIT OF CERTIORARI TO THE  
UNITED STATES CIRCUIT COURT OF APPEALS FOR  
THE SEVENTH CIRCUIT WITH AFFIDAVIT AND  
BRIEF IN SUPPORT THEREOF.**

---

*To the Honorable, the Chief Justice and the Associate  
Justices of the Supreme Court of the United States:*

James W. Waber files this petition for the writ of certiorari because the Circuit Court of Appeals for the Seventh Circuit, in entering a decree in a patent infringement suit, enunciated a novel, but erroneous, test of invention which has never been suggested by this Court and which is contrary to all tests approved and applied throughout the years.

For this reason, and others to be developed in the petition and brief in support thereof, James W. Waber respect-

fully petitions this Court to issue the writ of certiorari to review a decree of the United States Circuit Court of Appeals for the Seventh Circuit. The decree was entered on May 19, 1945 (R. 471) and it affirmed a final judgment of a Federal District Court (R. 338) adjudging that Letters Patent No. 1,808,091 duly issued by the Patent Office of the United States, are invalid.

The Petitioner accompanies this petition with a brief in support thereof and a certified transcript of the record in the case, including the proceedings in the Circuit Court of Appeals, in compliance with Rule 38, Section 1, Rules of this Court.

### **SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.**

On August 19, 1941 the petitioner filed a complaint (R. 2-5) in the United States District Court, Northern District of Illinois, Eastern Division, charging that respondents' products, "Airlock" Safety Tubes and "Master Seal" Tubes, infringed the petitioner's patent No. 1,808,091. This patent covers a puncture sealing pneumatic inner tube for use in automobile tires and its method of manufacture (R. 352-356). The application was filed on August 9, 1930 and was issued as a patent on June 2, 1931. It covers subject matter partially described in an earlier application filed on August 14, 1929 (R. 93-94) and abandoned by failure to respond to an office action of May 20, 1931 (Page 18, Exhibit N). During the prosecution of these two applications eight prior art patents were cited, including three later cited by the respondents in their answer and relied upon by the trial Court in its decision.

On November 26, 1941, the respondents filed their answer (R. 5-9), which among other things, denied infringement and asserted that said Letters Patent were invalid.



An amendment to the answer was filed on November 17, 1943 (R. 9-10). On the question of invalidity, the respondents relied upon twenty-eight patents as prior art (R. 7, 10) covering a cross section of the efforts of others from October 2, 1899 to October 27, 1931.

The trial commenced November 22, 1943 (R. 11). The testimony heard by the Court is printed at R. 20-262.

After the close of the testimony, and on December 23, 1943, the District Court handed down its oral decision (R. 325-332) that the patent in suit was infringed by the respondents but that it was invalid because it "is either anticipated by the prior art \* \* \* or \* \* \* it fails to disclose invention over such prior art" (R. 331). The trial Court found pertinent eight United States Letters Patent out of the twenty-eight cited by the respondents. Chronologically, beginning with the filing of the first patent and ending with the issuance of the last, the art relied upon by the Court evidences the development of the art from April 12, 1917 to September 4, 1928.

The trial Court relied upon the Wildman patent 1,601,013 (R. 328-330, 428), the Crombie patent 1,498,017 (R. 330, 412), the Armstrong patent 1,311,738 (R. 330-331, 406), the Wildman patent 1,507,646 (R. 331, 416), the Ostberg patent 1,565,813 (R. 331, 422), the Fetter patent 1,683,454 (R. 331, 432), the Ott patent 1,765,093 (R. 331, 436), and the Wallace patent 1,258,506 (R. 331, 392).\*

On January 10, 1944, the District Court entered its findings of fact and conclusions of law (R. 332-338), prepared

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\*The Wildman ('646), Fetter and Ott patents referred to above were cited by the Patent Office in the prosecution of the applications leading up to the issuance of the patent in suit. The two Wildman patents and the Crombie patent were discussed in detail by the trial Court. It included the remainder as a group "all in point." They were not specifically discussed. The Wallace, Wildman ('013), and Crombie patents were relied upon by the Circuit Court of Appeals in its decision.

by counsel for respondents (R. 331), and entered a final judgment (R. 338) adjudging the patent invalid.

On April 5, 1944, the petitioner filed his notice of appeal to the Circuit Court of Appeals for the Seventh Circuit (R. 339) which appeal was duly perfected and, on April 18, 1945, the Circuit Court of Appeals heard the petitioner's appeal (R. 463).

On May 19, 1945 the Circuit Court of Appeals entered its decree (R. 471) affirming the judgment of the District Court. The decree is supported by a published opinion (R. 464-471) reported in ... F. (2nd) ... and in 65 U. S. P. Q. 389. Of the twenty-eight prior art patents set up in the answer and the eight prior art patents relied upon by the District Court, the Circuit Court of Appeals found only three to be pertinent, namely, in order of importance, the Wallace patent 1,258,506 (R. 467, 392), the Wildman patent 1,601,013 (R. 467, 428), and the Crombie patent 1,498,017 (R. 467, 412).

In its opinion, the Circuit Court of Appeals stated that the Waber patent was anticipated by the Wallace patent and by the Wildman patent (R. 468-470).

That anticipation is lacking will be developed in the brief in support hereof. Waber discloses a new four step process. The Court of Appeals found that two of the four steps were not disclosed (R. 467-468) in Wallace (R. 392). With respect to the Wildman patent (R. 428), the Court's opinion states that the anticipating "language is not entirely clear" but nevertheless, "assuming, as we think we must," (R. 469) that Wildman "could be constructed" on an inflated tube, reached the conclusion of anticipation (R. 470). Such a disclosure does not support the anticipation defense.

There is no finding by either court that the "improvements (of Waber) were patented and described" in Wal-

lace, Crombie or Wildman, as pleaded in paragraph 14 (a) of the answer (R. 6-7) or that the same "were known and used by" them as pleaded in paragraph 14 (b) (R. 7).

In view of the lack of anticipation, the test of invention which was applied by the Circuit Court of Appeals is most important. Here lies the crux of the error of law made by the Circuit Court of Appeals and one which wholly substantiates this petition for the writ of certiorari. The Circuit Court of Appeals applied a new and unusual test, a test never suggested by this court nor contemplated by the Congress. The Circuit Court of Appeals' opinion states that invention is lacking because

"a person trained and skilled in the making of tubes, by studying and understanding this prior art, **could have duplicated** the accomplishment of Waber" (R. 470).\*

The editor of U. S. P. Q. in headnote 2 of the reported decision, states the new rule of the Circuit Court of Appeals as follows, 65 U. S. P. Q. 389:

"\* \* \* Court holds patent invalid since person skilled in art **could have duplicated** patentee's accomplishment by studying and understanding prior art."

The enunciation of this mistaken rule by the Circuit Court of Appeals is important both to the public and to this petitioner. If the rule be perpetuated, then it is obvious that few, if any, patents can be valid. This new rule is so strict that it forbids application of the "flash of genius" rule recently enunciated by this Court. Without its novel test, the Court's application of established tests would have impelled a finding that invention bred the Waber tube.

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\* All emphasis used in the petition and brief in support thereof is added by the petitioner except as otherwise noted.

It is also important that the Wallace, Crombie, and Wildman patents were abandoned. They did not partake of any useful or practical operation and nothing more was heard from the patentees or any other persons for a period in excess of 15 years. They were resurrected solely for the purposes of defense in this suit. They did not make a ripple on the sea of progress. Ternes, the respondents' expert, had never seen a tube made in accordance with the teachings of Wallace (R. 86), Crombie (R. 88, 89), or Wildman (R. 89). Waber testified that no prior art tubes are on the market (R. 22) and that none was or could be commercially successful (R. 199, 242, 246).

An affidavit of the petitioner is annexed to this petition, page 10, as Exhibit A. It shows that no one other than the respondents infringes the patent in suit. As a result there is little likelihood that acts of infringement will occur in any Circuit other than the Seventh. Conflicting decisions directly involving the patent in suit are therefore improbable.

### **JURISDICTIONAL STATEMENT.**

The jurisdiction of this Court is conferred by U. S. Code, Title 28, Sections 347 and 350. The judgment or decree sought to be reviewed is dated May 19, 1945 and this petition is presented within three months thereof.

### **THE QUESTIONS PRESENTED.**

The ultimate question presented for consideration by this Court is:

1. Was the Circuit Court of Appeals justified in holding a patent invalid upon the application of a negative test of invention that a person trained and skilled in the art, by studying and understanding the prior art, could have duplicated the accomplishments of the patentee?

Subordinate questions are:

2. Does a prior art patent (the Wallace patent 1,258,506) which fails to disclose two steps of four steps of the process of the patent in suit anticipate such a patent?

3. May anticipation be "assumed" by a patent (the Wildman patent 1,601,013) where the "language is not entirely clear"?

4. Is the Waber patent 1,808,091 valid in view of the Wallace patent 1,258,506, the Crombie patent 1,498,017 and the Wildman patent 1,601,013?

### **REASONS RELIED UPON FOR THE GRANT OF THE WRIT OF CERTIORARI.**

The discretionary power of this Court is invoked upon any one of the following grounds:

1. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent upon which the entire puncture sealing tube industry is founded, which industry (with the exception of the present respondents) is concentrated within the Seventh Circuit and which patent expires on June 2, 1948 (in less than three years) whereby a resulting conflict of decision is improbable.\*

2. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent on the unfair and erroneous ground that "a person trained and skilled in the (art) \* \* \*, by studying and understanding (the) \* \* \* prior art, could have duplicated the accomplishment of (the patentee)."

a. This holding presents a novel question of law which has never been decided by this court and one of general

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\*See Exhibit A, appended to this petition, page 10.

interest to the public. In principle, it is in conflict with decisions of this court.

b. This holding is contrary to the patent statutes and, therefore, is in direct conflict with applicable decisions of this court as constituting judicial legislation.

3. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a process patent comprising four steps upon the ground that it is anticipated by a prior art patent which does not disclose two of said steps. This holding is untenable because it is in direct conflict with applicable decisions of this court.

4. The Circuit Court of Appeals for the Seventh Circuit has stricken down a patent on the ground "assuming, as we think we must" that anticipation is present, although finding that the anticipating "language is not entirely clear." This holding is untenable because it is in direct conflict with applicable decisions of this court.

5. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent upon a broad construction beyond the disclosures of three prior art "paper" patents which failed of any useful or practical operation and from which nothing more was heard for a period of 15 years. A determination of invalidity based on such art is untenable because it is in conflict with the decisions of other Circuits Court of Appeals on the same matter and is probably in conflict with applicable decisions of this court.

6. The Circuit Court of Appeals for the Seventh Circuit has stricken down a patent as lacking invention contrary to established tests of invention. Failure to apply said tests is in direct conflict with applicable decisions of this court and with decisions of other Circuits Court of Appeals.

**PRAYER.**

Your petitioner prays that the writ of certiorari be issued to the United States Circuit Court of Appeals for the Seventh Circuit commanding said court to certify and send to this court, on a day to be designated, a full and complete transcript of the record of all of the proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this court; that the decree of the Circuit Court of Appeals affirming the final judgment of the District Court be reversed; and that the petitioner be granted such other and further relief as may seem proper.

JAMES W. WABER,  
*Petitioner.*

By: GEORGE I. HAIGHT,  
M. K. HOBBS,  
CARL HOPPE,

1041 Rookery Building,  
209 South LaSalle Street,  
Chicago 4, Illinois.

*Attorneys for Petitioner.*

Dated: Chicago, Illinois  
August 10, 1945.

**Exhibit A.****AFFIDAVIT IN SUPPORT OF PETITION FOR THE  
WRIT OF CERTIORARI.**

COUNTY OF COOK }  
STATE OF ILLINOIS } ss.

**JAMES W. WABER**, being first duly sworn, deposes and says:

Affiant is the petitioner in the above entitled matter;

Affiant knows the names and addresses of persons who manufacture puncture-sealing tubes in this country in accordance with the teachings of the Waber Patent No. 1,808,091;

Affiant is informed and believes that the Seiberling Rubber Company at one time did manufacture tubes at Akron, Ohio in accordance with said teachings, but that it stopped such manufacture shortly after December 7, 1941;

The only person or persons now manufacturing such puncture-sealing tubes is or are the petitioner himself and the respondent United States Rubber Company;

The entire puncture sealing tube industry is now concentrated in the State of Illinois within the Seventh judicial circuit of the United States with the exception of the possible manufacture by the respondent United States Rubber Company.

**JAMES W. WABER.**

Subscribed and sworn to before me this 10th day of August, 1945.

**FRANCES SAVAGE**  
Notary Public  
Cook County, Illinois

My commission expires June 27, 1948.







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**SUPREME COURT OF THE UNITED STATES**

OCTOBER TERM, 1944

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JAMES W. WABER,

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*vs.*

MONTGOMERY WARD & CO., INCORPORATED,  
AND UNITED STATES RUBBER COMPANY,

*Respondents.*

---

**BRIEF IN SUPPORT OF PETITION FOR THE WRIT  
OF CERTIORARI.**

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**PREFACE.**

The petitioner seeks allowance of the Writ of Certiorari principally because the Circuit Court of Appeals for the Seventh Circuit has enunciated a test of invention which has not been sanctioned by this Court, or any other court. Indeed, the novel test advanced by the Circuit Court of Appeals is contrary both to applicable decisions of this Court and to the stated intention of Congress. Petitioner seeks review at this time because no one other than the respondents infringes the patent in Circuits other than the Seventh Circuit. It is therefore unlikely that the petitioner may attain review from conflicting decisions directly involving the patent in suit.

### **OPINIONS BELOW.**

The opinion of the trial Court was delivered on December 21, 1943. It is not reported but it appears in the record at pages 325 to 332. Pursuant to the opinion, counsel for the respondents prepared findings of fact, conclusions of law and final judgment, all of which were signed by the trial Court on January 10, 1944. They are not reported, but the findings of fact appear in the record at pages 334 to 337, the conclusions of law, at pages 337 to 338, and the final judgment, at page 338.

The opinion of the Circuit Court of Appeals was filed on May 19, 1945. It appears in the record at pages 464 to 471, and is reported in . . . F. (2d) . . . , and in 65 U. S. P. Q. 389.

### **JURISDICTIONAL STATEMENT.**

The jurisdiction of this Court is believed to be conferred by U. S. Code Title 28, Sections 347 and 350. The judgment or decree sought to be reviewed is dated May 19, 1945 and this petition is presented within three months thereof.

The discretionary power of this Court is invoked upon the following grounds:

1. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent upon which the entire puncture sealing tube industry is founded, which industry (with the exception of the present respondents) is concentrated within the Seventh Circuit and which patent expires on June 2, 1948 (in less than three years) whereby a resulting conflict of decision is improbable.

2. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent on the ground that "a person trained and skilled in the (art) \* \* \* , by studying and understanding (the) \* \* \* prior art, could have duplicated the accomplishment of (the patentee)."

a. This holding presents a novel question of law which has never been decided by this court and one of general interest to the public. In principle, it is in conflict with decisions of this court.

b. This holding is contrary to the patent statutes and therefore is in direct conflict with applicable decisions of this court as constituting judicial legislation.

3. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a process patent comprising four steps upon the ground that it is anticipated by a prior art patent which does not disclose two of said steps. This holding is untenable because it is in direct conflict with applicable decisions of this court.

4. The Circuit Court of Appeals for the Seventh Circuit has stricken down a patent on the ground "assuming, as we think we must" that anticipation is present, although finding that the anticipating "language is not entirely clear." This holding is untenable because it is in direct conflict with applicable decisions of this court.

5. The Circuit Court of Appeals for the Seventh Circuit has stricken down as invalid a patent upon a broad construction of three prior art "paper" patents which never went into any useful or practical operation and from which nothing more was heard for a period of 15 years. A determination of invalidity based on such art is untenable because it is in conflict with the decisions of other Circuits Court of Appeals on the same matter and is probably in conflict with applicable decisions of this court.

6. The Circuit Court of Appeals for the Seventh Circuit has stricken down a patent as lacking invention contrary to established tests of invention. Failure to apply such tests is in direct conflict with applicable decisions of this court and with applicable decisions of other Circuit Courts of Appeals.

### STATEMENT OF THE CASE.

The facts are stated in the petition under the heading *Summary and Short Statement of the Matter Involved* (Petition pages 2 to 6). For the sake of brevity, they are not repeated here. They are, however, amplified, with a more detailed study of the opinion of the Circuit Court of Appeals.

Superficially, the opinion correctly and accurately states many of the facts which are before this court upon this petition. However, it should be carefully scrutinized, because of its many improper conclusions and inferences both of fact and law. A careful reading of the opinion leaves one impressed with its faulty reasoning.

The petitioner, as did the Circuit Court of Appeals (R. 466), discusses the process claim, namely claim 2, since it claims the process used in making the product claimed by claims 3 and 6. No other claims are involved.

Claim 2 (R. 466, 355) describes the Waber method of making puncture sealing inner tubes for pneumatic tires. This method comprises four steps, as follows:

- (1) forming an endless tube of vulcanizable rubber whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used,
- (2)a expanding said tube by internal pressure,
- (2)b applying to the outer circumference of said tube while inflated a layer of plastic sealing compound,
- (3) covering the said compound with a layer of vulcanizable rubber which extends beyond the edges of the compound and contacts with the endless tube for adhesion thereto
- (4) and curing the entire tube structure in a mold whose cavity is substantially equal to the size and shape of the cavity of the tire casing in which said tube is intended to be used.

For better ease of understanding, step 2 of the analysis of the claim, as made by the Circuit Court of Appeals (R. 466-467), has been broken into two sub-divisions, 2a and 2b.

The opinion of the Circuit Court of Appeals specifically states that a feature of Waber's invention is that Waber forms an inner tube "of a predetermined size" (R. 465), namely to dimensions which "are slightly smaller than the cavity in the tire casing in which said tube is intended to be used" (R. 466). Waber then partially inflates the inner tube and applies to the outer circumference a layer of plastic puncture sealing material. Thereafter he covers the puncture sealing material with a layer of rubber and then cures the entire completed tube in a mold of substantially the size and shape of the inner contour of the casing in which the tube is to be used.

Although the Circuit Court of Appeals does not so specifically state, each of the four steps recited in its opinion is essential to the Waber invention. Without all of them, there can be no infringement; without them there can be no invention—they represent the features not found in the prior art. The complete combination of four steps is that which the Patent Office found to be patentable over the prior art.

In its discussion (R. 467-468, 470) of the Wallace patent 1,258,506 (R. 392) the court failed to recognize the importance of each of the steps of the Waber process although the Court does properly describe the Wallace disclosure. One exception, which apparently does not form the basis of its decision, is pointed out solely in the interest of accuracy. The court characterizes the intermediate "layer of protective material" (R. 467-8) as "a ply of compounded rubber" (R. 468). It, in fact, is a ply of "protective textile fabric" which may be "textile fabric frictioned with a suitable compound of rubber and coated on one side with the same" (R. 400, Col. 1, lines 44-50).

The opinion also purports to apply the disclosure to claim 2. The Court's discussion of the basic facts points out two substantial differences.

First, the court explains that Wallace "does not explain (the) relative size and shape" (R. 467) of the base tube formed in step 1. However, the court thereafter ignores that the dimensions of the base tube of Waber "are slightly smaller than the cavity in the tire casing in which said tube is intended to be used" (R. 466). And this forgetfulness immediately follows the court's recognition of the fact that the patent recites that it is a "feature" that the base tube "is formed of a predetermined size" (R. 465) and its recognition of Waber's contention that "the base tube has the size and form it will have in ultimate use." (R. 467).

Second, the opinion points out that in step 2, Wallace provides "a layer of puncture resistant material" instead of Waber's "layer of plastic sealing compound" (R. 467-468) and that Wallace's layer "served to prevent puncture" whereas Waber's, contemplated "the sealing of a puncture" (R. 468). Pertinently Wallace does not suggest that a plastic sealing compound may be substituted for his layer of protective textile fabric.

After correctly pointing out that at least two features required and claimed by Waber are not disclosed by Wallace, the court then concludes "Waber is anticipated by Wallace."

The opinion turns next to the Crombie patent (R. 468, 412) but does not specifically rely upon this patent as an anticipation. However, the opinion does infer that Crombie discloses the process of Waber for it recites that Crombie "discloses a process for constructing inner tubes" (R. 468). A study of the patent itself (R. 412) proves that



there is no anticipation of the Waber process. Raymond F. Ternes, the respondent's expert and the head of the Tire Division of the Patent Department of the United States Rubber Company (R. 55), was unable to apply the Crombie disclosure to claim 2; he stated "the Crombie patent obviously is not a method patent" and contains "no disclosure of how it is made" with an exception that it does mention that the whole is constructed to form a tube and vulcanized in the usual manner (R. 88).

The Court's next prior art discussion revolves about the Wildman patent (R. 469-470, 428). Wildman does not disclose steps 1 and 2 of the Waber process.

First, the Waber step 1 requires the forming of an endless tube whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is to be used. The Court shows that Wildman, on the contrary, "contemplated in the main the idea of building the plastic and extra layers on the tube while it was on a straight pole mandrel" (R. 469). The Wildman patent contains no disclosure as to size, but the opinion does not discuss this feature; it should have done so.

The Circuit Court of Appeals does not dispose of the petitioner's contention, "that Wildman does not have Waber's step of building the extra plies on a base tube while it is inflated in the ring shape it will have in use" (R. 469). It is true that the Court does discuss building the additional plies upon an inflated inner tube, but this is in respect to step 2—the Court failed completely to mention the ring shape. If there be any doubt as to the meaning of the specifications, this brief contains an Appendix B pages 43 to 45 which describes the detailed method of Wildman as contained in his original disclosure. This matter was cancelled out of the application on February 9, 1926 (page 18, Exhibit 19) to meet a Patent Office requirement (page 17,

Exhibit 19). It amplifies the language quoted in the Court's opinion. The details set forth in the Appendix B clarify any ambiguity, if any there be, in the summary analyzed by the Circuit Court of Appeals. The trial court received the file history in evidence because it "might aid in the interpretation of the patent" (R. 253). The portion of the specification set forth in the Appendix should be read in conjunction with the original drawings at pages 305 and 307 of the record.

With respect to step 2 the Court failed to express any positive opinion as to whether the tube is inflated, *i.e.* whether an air mandrel is used. Carefully the Court stated that the "language is not entirely clear" and then used qualifying words, "assuming, as we think we must", to reach the indefinite conclusion that additional plies "could be constructed" on an inflated tube (R. 469). Pertinently the Court did not find that Wildman taught this feature.

Further, the Court's discussion of Wildman's use of five plies instead of the three used by Waber states "the function to be performed was the same whether the tube be constructed of 3 or 5 layers" (R. 470). The petitioner does not rely upon this error of fact to support the petition for the writ. However there is no evidence in this record which supports the conclusion. The respondents did not even offer to take testimony on this point. In cross examination Waber was asked if it would be easier to build a tube leaving out the plies 2 and 4 and Waber replied that he didn't think it would make much difference except in the splicing (R. 244). Ease of building is a far cry from identity of function.

It is upon the above facts and with the above deficiencies in mind that the Circuit Court of Appeals reached the ultimate conclusion that "Waber is also anticipated by Wildman."

Patently, in view of the differences pointed out by the Court itself in discussing both the Wallace and the Wildman disclosures, the words "anticipated by" are used in the sense of "lacks invention over."

Hence it becomes very important to know what was the test of invention which the Circuit Court of Appeals applied. From earlier portions of the opinion, we are led to believe that the test was one applied strictly against the inventor, being based on "language \* \* \* not entirely clear", "assuming", "as we think we must" and possibilities. We learn by further reading that the court applied the following negative test to reach its opinion that invention is lacking:

"We are of the opinion that a person trained and skilled in the making of tubes, by studying and understanding this prior art, **could have duplicated** the accomplishment of Waber" (R. 470).

The opinion of the court is silent with respect to the established objective rules of invention applied throughout the years, both by this Court and the several Circuits Court of Appeals. All of the standard rules have been discarded in favor of the Court's new subjective rule.

The Court concludes its opinion with a discussion of the commercial success of the Waber tube and an observation that it is unimpressed because Waber sold only 100,000 tubes during his peak year. As a "control" the Court selected ordinary non-punctureproof inner tubes with sales of 35 to 40,000,000; it ignored the fact that no puncture-resistant inner tube had ever been commercially successful prior to Waber (R. 220, this brief pages 39 to 40).

It is shown in the argument that there is unlikely ever to be any litigation elsewhere with a resulting conflict of decisions.

## **SPECIFICATION OF ERRORS.**

The errors of the Circuit Court of Appeals by this Court are:

1. The Circuit Court of Appeals was not justified in holding a patent invalid upon the application of a negative test of invention that a person trained and skilled in the art, by studying and understanding the prior art, could have duplicated the accomplishment of the patentee.
2. The Circuit Court of Appeals erred in holding that the Wallace patent 1,258,506, which does not disclose two of four steps of the patent in suit, anticipates the Waber patent.
3. The Circuit Court of Appeals had no power to "assume" anticipation by a patent (the Wildman patent 1,601,013) where the "language is not entirely clear."
4. The Circuit Court of Appeals erred in construing broadly the disclosures of three "paper" patents, namely, the Wallace patent 1,258,506, the Crombie patent 1,498,017 and the Wildman patent 1,601,013.
5. The Circuit Court of Appeals erred in finding the Waber patent 1,808,091 invalid in view of the Wallace patent 1,258,506, the Crombie patent 1,498,017 and the Wildman patent 1,601,013.

## **ARGUMENT.**

### **Summary.**

The argument starts with a short statement urging that this Court should exercise its discretionary power to assume jurisdiction because it is unlikely that there will be a conflict of decision resulting from litigation elsewhere.

It next discusses the test negating invention where a skilled person "could have duplicated" the accomplishment of the patentee. The brief argues that such a test is contrary in principal with pertinent cases and that it constitutes improper judicial legislation by the Circuit Court of Appeals. It is shown that the test is unsound because it is contrary both to the intention of Congress and to the declaration of national policy enunciated by the late President Roosevelt's "National Patent Planning Commission."

The Circuit Court of Appeals additionally found anticipation where specific claim limitations were lacking in the prior art disclosures. It is shown that such a conclusion is contrary to applicable decisions of this Court and another Circuit Court of Appeals.

The brief further submits that a finding of anticipation which is based upon "language not clear" and assumptions is contrary to decisions of this Court and is therefore untenable.

It is then urged that "paper" patents are not entitled to a broad construction on the question of the patentability of a later successful patent.

The concluding portion of the argument demonstrates that the Circuit Court of Appeals should have applied established tests of invention as set forth in applicable decisions of this Court and of other Circuits Court of Appeals. If it had done so, it would have been impelled to find that Waber's efforts and accomplishments rose to the dignity of real invention.

#### **1. A Resulting Conflict of Decision Is Improbable.**

At the present time, other than for the instant infringement by United States Rubber Company, no one makes the

Waber type tube other than Waber himself (Petition, Exhibit A). Seiberling, who at one time made Waber type tubes (R. 22, 296), has stopped its acts of infringement (Petition, Exhibit A).

Thus, the entire industry, except for respondents' infringing acts, is now concentrated within the Seventh Circuit.

Further, the manufacture of pneumatic inner tubes is strictly regulated by government Executive Order, namely: *Restrictions on consumption, deliveries, inventories, use and importation of rubber and products thereof*. C. F. R. Title 32, Ch. 9, Part 4600, Section 4600.01 et. seq.

Section 4600.02 thereof provides that no person shall consume rubber raw materials "without first obtaining authorization to do so from the War Production Board." The War Production Board has seen fit to allow rubber for only a very small number of Waber type tubes for only such special service as heavy duty service for such things as trucks and taxicabs (R. 121). The "Rubber Board" didn't want to use as much rubber as was necessary to make the puncture proof inner tube except for commercial use (R. 35).

It is also pertinent that the patent expires on June 2, 1948, it having issued on June 2, 1931 (R. 352). This is a period of less than 3 years from today.

In view of the present limited market and the length of time it would naturally take for production tooling, it is improbable that any new infringers will crop up during the next 3 years in the Seventh or in any other Circuit.

In consequence, the words of this Court in *Schriber-Schroth Company v. Cleveland Trust Company*, (1938) 305 U. S. 47, at page 50, apply:

"litigation elsewhere with a resulting conflict of decision (is) improbable"

See also *Muncie Gear Works, Inc. et al. v. Outboard, Marine & Manufacturing Co. et al* (1942) 315 U. S. 759 where, page 766, it is said that "litigation in other Circuits, resulting in a conflict of decisions, is unlikely."

## **2. The Test of Invention Applied By the Circuit Court of Appeals Is Not Sanctioned By Authority.**

The crux of the error of law made by the Circuit Court of Appeals and one which wholly substantiates this petition for the writ of certiorari is that the Circuit Court of Appeals applied a new and unsound test. It is one never suggested by this Court or contemplated by the Congress. The Circuit Court of Appeals states that invention is lacking because

"a person trained and skilled in the making of tubes, by studying and understanding this prior art, **could have duplicated** the accomplishment of Waber." (R. 470.)

In view of the attempts and failures of others to produce a puncture proof inner tube, with efforts extending over a period of nearly 40 years, during the last 12 of which the most important prior art patent, the Wallace patent, was available to the public, it is difficult to understand that such an opinion could be reached. But that difficulty does not supply the primary basis for this writ. It is the test itself which warrants complaint. The test is such a burden upon the patent system that it is not conceivable that any inventor will ever be able to meet it.

a.) *The new rule presents a novel question of law which, in principle, is in conflict with decisions of this court.*

The enunciation of this novel rule by the Circuit Court of Appeals is important both to the public and to this petitioner. If the rule be perpetuated, then it is obvious

that no patent could be valid. This new rule is so strict that it forbids application of the "Flash of genius" rule recently enunciated by this Court which latter rule has been the subject of much discussion because of its apparent strictness.

The test applied by the Circuit Court of Appeals is clearly analogous to the negative test suggested and condemned by this court in *O'Reilly, et al v. Morse, et al* (1853) 15 How. (56 U. S.) 62. The defendant in that case alleged that Morse was not the true and original inventor of the telegraph because Morse studied and obtained information from prior sources. The Supreme Court correctly denied the defense, stating, at page 111 as follows:

"Neither can the inquiries he made, or the information or advice he received, from men of science in the course of his researches, impair his right to the character of an inventor. No invention can possibly be made consisting of a combination of different elements of power, without a thorough knowledge of the properties of each of them, and the mode in which they operate on each other. And it can make no difference, in this respect, whether he derives his information from books, or from conversation with men skilled in the science. If it were otherwise, no patent, in which a combination of different elements is used, could ever be obtained. For no man ever made such an invention without having first obtained this information, unless it was discovered by some fortunate accident. And it is evident that such an invention as the Electro-Magnetic Telegraph could never have been brought into action without it. For a very high degree of scientific knowledge and the nicest skill in the mechanic arts are combined in it, and were both necessary to bring it into successful operation. And the fact that Morse sought and obtained the necessary information and counsel from the best sources, and acted upon it, neither impairs his rights as an inventor, nor detracts from his merits."



The Circuit Court of Appeals in the instant case goes even further than was suggested in the *Morse* case and holds a patent to be invalid if one skilled in the art **could have duplicated** the invention by a study of prior art sources. If a patent is not invalid where in fact the patentee **did study** the prior sources, there is no merit in a holding that a patent is invalid where he **could have duplicated** the invention by a study of the same sources.

The question which the Court really should have answered is whether one of ordinary skill in the art, before anyone had thought of the Waber invention, would have constructed a puncture sealing tube in accordance with Waber's teachings after seeing the Wallace disclosure and the many patents disclosing a plastic sealing compound. That he would not, is eloquently testified to by the fact that such disclosures had been a part of the public commons since at least 1918 and **no one did think of it except Waber**. It is easy after the problem has been solved to see the solution but that should not deprive the one who showed the way the status of an inventor.

In *Electric Storage Battery Co. v. Shimadzu, et al.* (1939) 307 U. S. 5, the Court granted *certiorari* because among other reasons, page 8, the case presented a question "which should be settled by this court."

b.) *The new rule is contrary to the patent statutes and therefore constitutes judicial legislation.*

Congress did not intend that the Patent Laws should be evaded by an infringer merely because someone else **could have duplicated** the invention. The intention of Congress was clearly expressed upon this very subject when the patent laws were codified in 1870. Congress looked at patents objectively not subjectively. Representative Jenckes was in charge of the passage of the codification in the House, and in explanation of the patent

system, which the code was designed to define and protect, he said, 93 Congressional Globe, page 2878 (April 21, 1870 issue):

“But why protect it at all, say many. If an invention had not been perfected by this patentee today it would have been at some subsequent time by some other inventor. Why not wait and let it be produced in course of time, according to the necessities of the art in which it is developed, and without expense to the public? This objection touches precisely the point of the whole matter, and affords the best argument for the patent laws. It admits that invention is a question of time, and that the results of invention are desirable and valuable. The patent laws offer a premium upon the earliest time. If it be known that any art or manufacture could be improved by invention in any particular, the question is, is it likely that such improvement will be made sooner by protection of the inventor, or will it be delayed indefinitely without such protection? The solution of this question does not rest in speculation. The history of inventions determines it. The loom is as old as civilization, but the power-loom was perfected under the stimulus and protection of the patent laws. So was the machinery for spinning. The philosophy of steam may have been ancient, but the steam-engine is a creature of the patent laws.

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When it is said that an invention would have been made at some time if not at the time when it was made, without the stimulus of the patent laws, who can tell at what time? When would any modern invention that might be named, the sewing-machine, for instance, have been produced if the inventors had not expected a profit upon it?”

The above language and the entire tenor of Representative Jenckes analysis (Appendix C, pages 46 to 58) illustrates that the Congress intended to test invention objectively rather than subjectively.

The report of the National Patent Planning Commission, 78th Congress, 1st Session, House Document No. 239, page 6, varied not in the slightest from the original stated intention of Congress, for it recommended

“the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished.”

Representative Jenckes had stated:

“The patent laws offer a premium on the earliest time.”

Both now and then an objective approach to the term “invented” is sound public policy. The new test of the Circuit Court of Appeals is unsound under any standard of judgment.

The 1870 code contained substantially the provision now incorporated in U. S. Code, Title 35, Section 69. That section does not provide the defense that a patent should be invalid if a skilled mechanic **could have duplicated** the invention. Furthermore the portion entitling a person to a patent, now U. S. Code, Title 35, Section 31, requires merely that the invention be “not known or used by others in this country \* \* \* and not patented”; it does not provide the harsh rule applied in the instant case by the Circuit Court of Appeals.

In effect, the Opinion of the Court has taken the Second defense enacted by Congress in U. S. Code, Title 35, Section 69 and has rewritten it entirely. The Second defense provides:

“That he (the patentee) surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same;”

The defense, as rewritten by the Circuit Court of Appeals for the Seventh Circuit, now reads:

"That he (the patentee) obtained the patent for, that which could have been duplicated by another."

Note that "was in fact invented" is the very antithesis of "could have been duplicated". Further, the Circuit Court of Appeals ignores the statutory limitations "sur-reptitiously or unjustly" and the limitation that the other person "was using reasonable diligence in adapting and perfecting the same."

Thus, the Circuit Court of Appeals, has applied a standard of invention denied by the Supreme Court and wholly beyond the expressed intention of the Congress. By imposing upon the patent system burdens which the legislature has not provided, the Circuit Court of Appeals has stepped beyond the Constitution, contrary to applicable decisions of this court.

In *Electric Storage Battery Co. v. Shimadzu, et al.* (1939) 307 U. S. 5, the defendant in a patent infringement suit requested relief which was not plainly stated in the statute. At page 14 the Court said:

"We cannot thus rewrite the statute. \* \* \* Congress has not seen fit to amend the statute in this respect and we must assume that it has been satisfied with, and adopted, the construction given to its enactment by the courts."

In *A. C. Frost & Co. v. Coeur D'Alene Mines Corp.* (1941), 312 U. S. 38, plaintiff brought an action under the Security Act of 1933 and requested relief for an act not specifically provided for in the Securities Act. At page 43 the court said:

"Courts have often added a sanction to those prescribed for an offense created by statute where the cir-

cumstances fairly indicated this would further the essential purpose of the enactment; but we think where the contrary definitely appears—actual hindrance indeed of that purpose—no such addition is permissible.”

In the instant case the new rule of the Circuit Court of Appeals is an actual hindrance to the purpose of the legislature.

**3. The Observation By The Circuit Court of Appeals That the Wallace Patent Anticipates the Waber Patent Is Contrary To Applicable Decisions of This Court.**

The Circuit Court of Appeals observed that “Waber is anticipated by Wallace” (R. 468). The decision is untenable because it is in direct conflict with applicable decisions of this Court. Anticipation and infringement are each subject to the same rules. That which would not infringe does not anticipate.

This brief is supplemented with “Appendix A,” page 42a. “Appendix A” is a side by side correlation of the elements of Claim 2 and the disclosures of the three principal prior art patents. For the sake of convenience, the disclosures of the prior art patents have been slightly reworded to correspond as much as possible to the language of the Claim 2 under consideration. It is believed that this rewording has been wholly accurate; all doubts have been resolved in the respondents’ favor.

For ease of comparison, the Appendix incorporates both bold face type and italics. The normal type indicates Waber features found in the prior art disclosures; the bold face type indicates Waber features that are not found in the prior art disclosures; and the type in italics, within parenthesis, represents undesirable features of the prior art disclosures which Waber has eliminated.

A glance at Appendix A conclusively shows that none of the prior art disclosures can possibly be construed either to anticipate or to infringe the Waber Claim 2.

For instance, referring to Wallace, we find that Wallace does not use a base tube "slightly smaller than" the intended cavity. The opinion states that Wallace "does not explain its relative size and shape" (R. 467). At best, the Wallace base tube is substantially smaller, being two-thirds the size of the cavity (R. 400, Col. 1, line 13; R. 418, Col. 1, lines 29-32; Appendix A, page 42a, footnote 4). With respect to steps 2 and 3 Wallace uses a protective textile fabric instead of "plastic sealing compound."

Petitioner also points out that the respondents did not offer any evidence that there is an equivalency between "slightly smaller" and "one-third smaller," or between "plastic sealing compound" and "protective textile fabric." The respondents had the burden of proving such a fact if it be true. Failure of proof can not be supplied by conjecture or argument. Wallace's lack of success argues that there is no equivalency here.

These differences would prevent infringement, likewise they do prevent anticipation.

The elements of a claim and their limitations must be regarded as material upon the question of infringement. *I. T. S. Co. v. Essex Co.* (1926), 272 U. S. 429, 444.

The failure of the Circuit Court of Appeals to apply claim limitations is also contrary with the decision of another Circuit Court of Appeals on the same matter. In *Philadelphia Rubber Works Co. v. Portage Rubber Co.* (C. C. A. 6, 1917), 241 Fed. 108, 110, the court said:

"\* \* \* limitations as to degree and time in the process correspond to the limitations as to shape, size, or location in the mechanical combination. If these

limitations as to shape, size, and location are essential to the new result reached, they form a necessary part of the invention; but, whether necessary or not, they cannot be disregarded if they have been inserted to meet the demands of the Patent Office, or if they have been deliberately and with industry adopted, even though voluntarily."

There is no question that anticipation and infringement are each subject to the same rules.

In *Commercial Manufacturing Company v. Fairbank Canning Company* (1890), 135 U. S. 176, the Court discussed the question of anticipation, and at page 194 the Court applied the rule that a patent is anticipated if a manufacture "by the precise process" described in the prior patent would be an infringement.

In *Knapp v. Morss* (1893), 150 U. S. 221, the Court applied the rule, at page 228, that if the prior patents were subsequent in date to that of the patent in suit, they would constitute an infringement thereof, there was anticipation because the rule, well established, is "that which infringes, if later, would anticipate if earlier." This latter rule is repeated in *Miller v. Eagle Manufacturing Co.* (1894), 151 U. S. 186 at page 203.

#### **4. The Determination By The Circuit Court of Appeals That the Wildman Patent Anticipates the Waber Patent Is Contrary To Applicable Decisions of this Court.**

The Court concluded that "Waber is also anticipated by Wildman" (R. 470). The conclusion is untenable. The Wildman patent does not disclose the "endless" tube required for step 1, nor does it disclose that the dimensions of the base tube are "slightly smaller than" the cavity in which the tube is to be used. It does not describe the air mandrel required by step 2 (a). Further, it requires a

splicing step to form the completed tube, which results in a five step process as compared with the four step process of Waber.

A holding of anticipation upon these facts is in conflict with the same decisions cited immediately above.

Further, the Court's conclusion is based on assumptions and conjecture as to the Wildman disclosure. The opinion relies upon anticipating "language \* \* \* not entirely clear" (R. 469) and reached the conclusion of anticipation "assuming as we think we must." Certainly this language of the court proves that the Wildman disclosure is not in "such full, clear, and exact terms as to enable any person skilled in the art" to use Waber's method. For this reason the opinion of the Circuit Court of Appeals is in conflict with applicable decisions of this Court.

The rule with respect to anticipation is very aptly put in *Seymour v. Osborne* (1870), 11 Wall. (78 U. S.) 516, 555, wherein the court states the rule with respect to foreign publications and prior patents, stating that the rule is the same for each. This Court held that a patented invention cannot be superseded (anticipated)

"unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains, to make, construct, and practice the invention. \* \* \* Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use."

In *Gordon v. Warder* (1893), 150 U. S. 47, the Court held that a prior patent did not serve as an anticipation, although the specification in that case did contain a paragraph stating that it might be advantageous, in some cases,



to make the device claimed in the later patent. The Court pointed out that no means were there provided, or method pointed out, whereby such a desired result could be obtained (page 50).

Even if we were to combine the teachings of all three prior art patents, which of itself might be the act of invention, there still would be no anticipation. None of the prior art patents explains the relative size and shape of the base tube and explains that the dimensions of the base tube should be slightly smaller than the cavity of the tire casing in which this tube is intended to be used. Further, such combination for the purposes of anticipation is forbidden by *Bates v. Coe* (1878), 8 Otto (98 U. S.) 31 at page 48, where the Court held that:

“Where the thing patented is an entirety, consisting of a single device or combination of old elements, incapable of division or separate use, the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire thing is found in one prior patent or printed publication or machine, and another part in another prior exhibit, and still another part in a third one, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement.”

*Imhaeuser v. Buerk* (1879), 11 Otto (101 U. S.) 647, 660; and *Parks v. Booth* (1880), 12 Otto (102 U. S.) 96, 103-104 reiterate this principle.

In *Topliff v. Topliff and another* (1892), 145 U. S. 156, 161 it is said:

“It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions.”

It should be noted that this section on anticipation eliminates all discussion as to whether or not the elimination of the steps applying the additional 2 plies of Wildman affects the question of anticipation. Although no evidence was taken by the respondents, it is felt that there are sufficient other distinctions that the point need not be argued at this time.

**5. A Broad Construction of Prior Art "Paper" Patents Which Never Went Into Any Useful or Practical Operation and From Which Nothing More Was Heard For a Period in Excess of 15 Years Is in Conflict With the Decisions of Other Circuits Court of Appeals and With Applicable Decisions of this Court.**

The Circuit Court of Appeals sustained the respondents' defense of anticipation or lack of invention over the prior art. The defense sustained by the Circuit Court of Appeals rests upon the patents for improvements issued to Wallace, Crombie, and Wildman; which improvements were finally abandoned. They never went into any useful or practical operation, and nothing more was heard of them from the patentees or any other persons for a period in excess of 15 years.

Waber, who had been in the tire business since 1924 (R. 21), had never seen a successful tube made in accordance with these prior art teachings (R. 22, 220) and Ternes, the respondents' expert, had never seen a puncture sealing tube made in accordance with the teachings of Wallace (R. 86) Crombie (R. 88, 89), or Wildman (R. 89).

The finding of invalidity based upon such prior art is probably in conflict with applicable decisions of this court, and principally with dictum in *Whitely v. Swayne* (1868), 7 Wall. (74 U. S.) 685. At page 687 the court said:

"Clearly, if any other person had chosen to take up the subject of the improvements, where it was left

off by \* \* \* (a patentee whose improvements were finally abandoned, which never went into any useful or practical operation, and from which nothing more was heard for a period of 6 years), he had a right thus to enter upon it, and if successful, would be entitled to the merit of them as an original inventor, for he is the first inventor, and entitled to the patent, who, being an original discoverer, has first perfected and adapted the invention to actual use."

*Deering v. Winona Harvester Works* (1894), 155 U. S. 286, involves the construction of a "paper" patent upon the analogous question of infringement. At page 295, the Court indicated that a "paper" patent is entitled to but a very narrow construction, stating:

"But in view \* \* \* of the fact that his invention was of doubtful utility and never went into practical use, the construction claimed would operate rather to the discouragement than the promotion of inventive talent."

The opinion of the Circuit Court of Appeals, being based upon unsuccessful prior art, is also in conflict with decisions of other Circuit Courts of Appeals on the same matter including the following:

In *Williams Iron Works Co. v. Hughes Tool Co.* (C. C. A. 10, 1940), 109 F. (2nd) 500, 510, the court said:

"A prior patent which fails to solve the problem toward which the inventor's efforts are directed does not anticipate a subsequent patent which successfully solves the problem and effectually accomplishes the desired results."

In *Farmers' Manufacturing Co. v. Spruks Mfg. Co. et al.* (C. C. A. 4, 1904), 127 Fed. 691, the court discussed a prior art patent which had been issued for 29 years when the application of the patent in suit had been filed. At page 693, the court said:

“For nearly 30 years it had been on the public record without producing any effect on the art or trade of barrel making. It cannot be said that a patent for a device which fails to accomplish the desired end is an anticipation of one which successfully accomplishes it.”

In *Kings County Raisin & Fruit Co. et al. v. United States Consolidated Seeded Raisin Co.* (C. C. A. 9, 1910), 182 Fed. 59, the prior art patent, the Crosby patent, was issued in 1866 and the patent in suit, the Pettit patent, was issued in 1899. At page 62 the court said:

“The Crosby invention undoubtedly anticipates and describes the whole theory of the Pettit patent; but it does not appear ever to have been put to use, and there is no evidence that any machine was ever constructed under it. It is one thing to invent the theory of a machine. It is quite another thing to invent a successfully operating machine. A third of a century passed between the date of that patent and the date of the Pettit patent, and in that time the evidence is conclusive that raisin seeding was done by hand, and that seeding by machinery was an unknown art. The Pettit machine was the first to go into use, and it went into very extensive and successful use. \* \* \*”

“It is probably unnecessary, on this appeal, to determine just what effect should be given to the Crosby patent as limiting the scope of the Pettit invention. It would seem that it was one of those unsuccessful and abandoned inventions which are held to have no place in the art to which they relate. In an analogous case, Mr. Justice Brown said: ‘His efforts in that direction must be relegated to the class of unsuccessful and abandoned experiments, which, as we have repeatedly held, do not affect the validity of a subsequent patent.’ *Deering v. Winona Harvester Works*, 155 U. S. 286, 302.”

In *Diamond Patent Co. v. S. E. Carr Co.* (C. C. A. 9, 1914) 217 Fed. 400, 405, the court said:

“The novelty of an invention is not negatived by a prior useless process or thing, nor is anticipation made

out by a device which might, with slight modification, be made to perform the same function. The invention must have been complete, and capable of producing the result. One should not be deprived of the results of a successful effort merely because someone else has come near it."

In *Babcock & Wilcox Co. v. Springfield Boiler Co., et al.* (C. C. A. 2, 1927) 16 Fed. (2nd) 964, 969, the court said:

"Prior patents, none of which solved the problem, can have no effect in anticipating, qualifying, or defeating the claims for patent protection of those whose subsequent effort produced success."

#### **6. Established Tests of Invention Prove the Patentability of the Waber Contribution.**

The Circuit Court of Appeals should have tested the presence of invention by the objective tests enunciated by this Court throughout the years. Had it done so, the Court would have been impelled to find that Waber's contribution was inventive.

In the interest of brevity, the facts showing the presence of invention will be stated summarily.

The rubber art is one in which small changes are important (*Encyclopedia Britannica*, 1945 Edition, Vol. 19, page 605; Vol. 7, page 743; *The Americana*, 1928 Edition, Vol. 23, pages 742-744; *Rubber Company v. Goodyear*, 9 Wall. 788, 793; *Diamond Rubber Co. v. Consolidated Tire Co.* 220 U. S. 429, 434, 440).

In the instant case, the principal prior art patent, that of Wallace, was available to the public since 1918 (R. 392). A plastic sealing compound between two layers of vulcanizable rubber is disclosed as early as the Armstrong patent of 1919 (R. 406). If there were no invention involved in discovering the Waber method, it seems peculiar that no one, except Waber, was able to make the discovery in the period since 1918-1919.

Waber's contributions were a step beyond the prior art and showed the public how to make a successful tube. First, Waber teaches that the base tube must be "slightly smaller" than the cavity of the tire casing (R. 466, 467). Second, Waber teaches that "plastic sealing compound" should be applied to a base tube which is inflated for use as an air mandrel (R. 466, 467). Third, Waber for the first time describes the complete combination of all four steps which are necessary for a successful tube and he gives the necessary details for each step (See claim 2, R. 466, 467). Thus, Waber has taught three things not found in any prior art patent. The respondents use them all.

These teachings of Waber have many practical accomplishments. Most important is that his was the first successful puncture sealing tube. As a result, Waber tubes last longer than regular tubes and may be used for from two to four casings (R. 48, 31, 32, 261). They may be driven 50,000 miles compared to 10,000-12,000 miles for the regular tube on trucks (R. 257). The period between inflations is reduced (R. 32, 260). Spare tires are eliminated (R. 261, 32). There are no flat tires to be changed (R. 260). A Waber tire can be driven from 500 to 1,500 miles with a puncture without losing air (R. 38, 147). They retain their balance and shape (R. 185, 32).

None of the prior art tubes had any of these advantages because no one had ever been able to make one successfully. The experts for both petitioner and respondent had never seen a successful prior art puncture sealing tube (R. 86, 88, 89, 22, 220).

A need and demand for a puncture sealing tire had long existed—it began with the first use of the pneumatic tube. Waber, himself, needed them in his business (R. 22). Prior to Waber, the art labored hard beginning in 1892 (R. 24, 7, 10) to solve this problem and to meet the public need. No one was successful (R. 22, 220, 24, 23, 86, 88, 89). Waber

examined 75 to 100 patents (R. 24) but found none he could use.

All of the efforts of those prior to Waber were failures. Ternes, the patent expert for the tire division of United States Rubber Company (R. 55) examined several thousand copies of patents; yet none of them was successful, for the United States Rubber Company found it necessary to infringe the Waber patent (R. 327-328, 337).

When Waber started to search for puncture proof tubes, he found none although he tried every place (R. 22). Today none of the prior art tubes is on the market (R. 220). Others had tried for a long time and several inventions had been developed and tried and failed (R. 24). Some of them were manufactured for a time (R. 24, 220) but none is now on the market except Waber type tubes (R. 22, 220).

In the effort to meet the public demand for a puncture resistant tube, some turned to a "compression type" tube (R. 23). None of these are now on the market, they had no protracted success. At the time of a big advertising campaign a good many would be sold for a period, but in sales, they all flattened out and the manufacturer would discontinue them (R. 23).

A Wallace tube is necessarily a failure, it will leak (R. 201). Further, Ternes, the respondents' expert, had never seen a tube made in accordance with Wallace (R. 86). The respondents do not sell a commercial Wallace tube; they sell Waber. They use the Waber method.

Crombie also was unsuccessful as was Wildman, for Ternes had never seen a tube made in accordance with these disclosures (R. 88, 89). Waber had never seen a successful tube of this type (R. 246). The respondents do not sell a commercial Crombie or Wildman tube. They use the Waber method.

After setting up several individuals and companies (R. 10) alleged to have known or used (R. 7) the Waber type



tube prior to Waber, the respondents failed to take supporting testimony. Presumably, these efforts too, were failures.

With this background of failures and broken dreams Waber himself embarked upon the solution of the problem. He started in 1924 (R. 21). In 1928 (R. 26) he was ready to manufacture the Waber tube. Waber, and he alone, succeeded.

He tried to have it built by all of the big companies, including the United States Rubber Company (R. 26). But even with the solution at hand, Waber was beset with difficulties. No one would build the tube, even if paid, because of bad experience in trying to build puncture proof tires (R. 26). Puncture proof tires were not a good thing to manufacture (R. 27). Finally, through the interest of Montgomery Ward, Waber was able to coax the Gillette Rubber Company into building a few hundred tubes (R. 26).

At first the tubes went to a few fleet operators (R. 26) to find out how they would actually perform in service (R. 28). Today the tubes are used on bicycles, automobiles, trucks, aeroplanes, industrial wheels and every place where pneumatic tires with inner tubes are used (R. 29). They are used by the Government, Illinois Bell Telephone Company, Marshall Field, Pure Oil, Kraft Cheese, Purity Baking Company, Ward Baking Company, United Parcel Delivery, Chicago Daily News, and a good many more (R. 29, 26, 41, 42, 256-258, 259-261). Many of these discriminating and careful users of pneumatic tubes have turned to the Waber tube practically exclusively (R. 41, 258, 261).

Every fleet that began to use the Waber tube does so almost exclusively at this time (R. 32).

The Waber tube attained an end not attained by anything in the prior art, and has been accepted as the termination of the struggle for a completely successful puncture sealing tube.



At first the trade scoffed at Waber's tube (R. 26, 27), but finally it started to manufacture by his method (R. 26, 28, 327, 328, 337). Successful Waber type tubes were manufactured and sold by the respondents, by Seiberling (R. 22) and by Waber. All are the Waber method (R. 296, 327-328, 335, 336, 337). They were the only successful puncture sealing tubes on the market.

Waber's sales rose from a few hundred in 1928 (R. 28) to 5,000-6,000 in 1930 (R. 31) to 200 a day for 1934 to 1941 (R. 35) and exceeded 100,000 by 1941 (R. 31). The respondents' sales for Waber type tubes were 30,000 for 1940 and 1941 (R. 123). In addition, Seiberling manufactured and sold Waber type tubes (R. 22, 283, 296). No prior art puncture sealing tube was successful (R. 220).

The tubes have sufficient merit that the War Production Board today permits the use of the additional rubber for tubes needed for heavy duty service (R. 35, 121).

Waber's success was beset with difficulties: First, no one wanted to make the tube (R. 26-27); Second, a Waber type tube sells at a premium price (R. 104-105); Third, Waber did not indulge in expensive advertising campaigns (R. 38), he sold his tubes on a trial basis (R. 31); and Fourth, Waber was competing with the large established manufacturers (R. 234, 22, 283).

Further evidence of invention arises from the fact that the respondents, after a thorough familiarity with the Waber method (R. 26, 28, 297, 298, and 149) and a study of several thousand patents (R. 55), began to follow Waber (R. 285, 123, 121, 283, 265, 327-328, 335-336, 337). They did not adopt any prior art tube or method. They accepted the benefit of the teachings of the Waber patent, and now assert that the teachings are worthless. They use the Waber method.

This Court and the several Circuits Court of Appeals have always considered such evidence to be impelling evidence that the discovery is patentable.

In preference to objective established tests, the Circuit Court of Appeals for the Seventh Circuit has held a patent invalid because someone else "could have duplicated" it. But the design of the patent laws is to encourage progress by granting the reward to the one who did it.

### CONCLUSION.

In conclusion, the petitioner quotes from the Report of the National Patent Planning Commission:

"It would be highly desirable and a great step forward if patents could be issued with a greater assurance that their validity would be upheld by the courts. No other feature of our law is more destructive to the purpose of the patent system than this uncertainty as to the validity of a patent."

Petitioner earnestly prays that the petition for the writ of certiorari be grant, that the case be reviewed and that the decree of the Circuit Court of Appeals for the Seventh Circuit, finding invalidity of the Waber Patent No. 1,808,091, be reversed.

Respectfully submitted,

GEORGE I. HAIGHT,

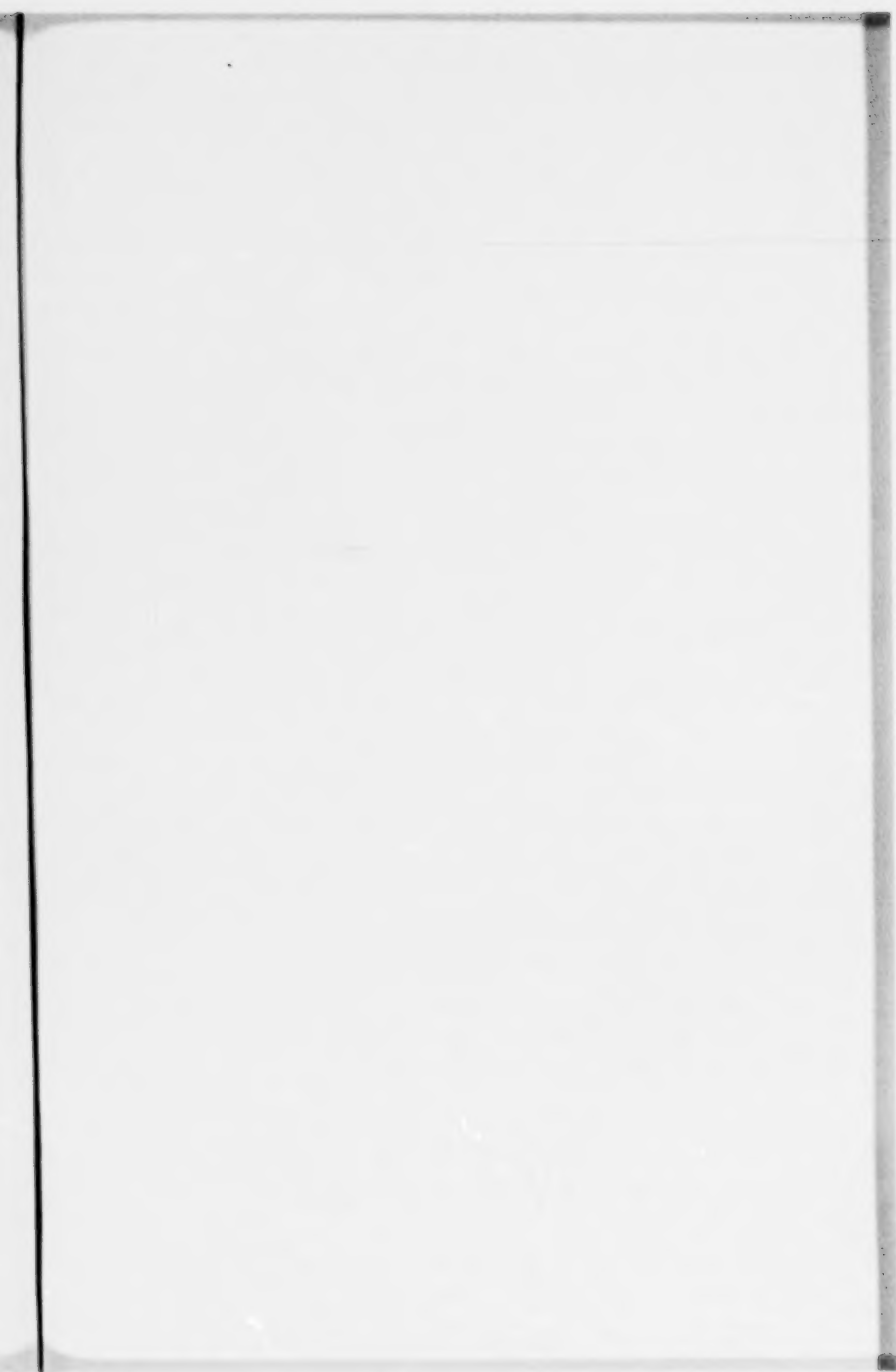
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Dated, Chicago, Illinois  
August 10, 1945.



<p>WABER PATENT IN SUIT No. 1,808,091 (R. 352)</p> <p>SPECIFICATIONS DISCUSSED IN OPINION (R. 465)</p>	<p>WABER PATENT IN SUIT No. 1,808,091 (R. 352)</p> <p>CLAIM 2</p>
A feature of my invention is the provision of a tube structure having	The method of making an inner tube for pneumatic tires which consists in
(1) an inner layer of elastic material which is formed of a predetermined size <sup>1</sup>	(1) forming an endless tube of vulcanizable rubber whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used,
(2)a (described in specifications) <sup>2</sup> (2)b which inner layer then has applied to the outer circumference thereof a layer of mastic puncture sealing material,	(2)a expanding said tube by internal pressure, <sup>3</sup> (2)b applying to the outer circumference of said tube while inflated a layer of plastic sealing compound,
(3) and an outer layer of elastic material	(3) covering the said compound with a layer of vulcanizable rubber which extends beyond the edges of the compound and contacts with the endless tube for adhesion thereto,
(4) which structure is then cured in a mold of substantially the same size and shape as the inner contour of the casing which receives the tube.	(4) and curing the entire tube structure in a mold whose cavity is substantially equal to the size and shape of the cavity of the tire casing in which said tube is intended to be used
FOOTNOTES	
<sup>1</sup> the basic tube portion * * * is first formed as an annular, endless tube of a size slightly smaller than the inner cavity of the casing with which it is to be used (R. 355, col. 1, lines 15-19).	<sup>2</sup> to the point where it is fully expanded but under substantially no tension. In other words, it is inflated to about the size it will have when it is placed in use (R. 355, col. 1, lines 21-25).
<sup>2</sup> the basic tube * * * is inflated to the point where it is fully expanded but under substantially no tension. In other words, it is inflated to about the size it will have when it is placed in use (R. 355, col. 1, lines 21-25).	

Note. In this comparison of the prior art disclosures with the process claim in suit, the elements or portions of said prior art disclosures, represent unsatisfactory features found in the prior art patents, which the Weber disclosure or

<p>WABER PATENT IN SUIT No. 1,808,091 (R. 352)</p> <p>CLAIM 2</p>	<p>WALLACE PATENT No. 1,258,506 (R. 392)</p> <p>DISCLOSURE</p>
The method of making an inner tube for pneumatic tires which consists in	The method of making an inner tube for pneumatic tires which consists in
(1) forming an endless tube of vulcanizable rubber whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used,	(1) forming an endless tube of vulcanizable rubber whose dimensions are <b>slightly smaller than (about two-thirds the size of)</b> <sup>4</sup> the cavity in the tire casing in which said tube is intended to be used,
(2)a expanding said tube by internal pressure, <sup>5</sup> (2)b applying to the outer circumference of said tube while inflated a layer of plastic sealing compound,	(2)a expanding said tube by internal pressure, <sup>5</sup> (2)b applying to the outer circumference of said tube while inflated a layer of <b>plastic sealing compound (protective textile fabric)</b> ,
(3) covering the said compound with a layer of vulcanizable rubber which extends beyond the edges of the compound and contacts with the endless tube for adhesion thereto,	(3) covering the said <b>compound (fabric)</b> with a layer of vulcanizable rubber which extends beyond the edges of the <b>compound (fabric)</b> and contacts with the endless tube for adhesion thereto,
(4) and curing the entire tube structure in a mold whose cavity is substantially equal to the size and shape of the cavity of the tire casing in which said tube is intended to be used.	(4) and curing the entire tube structure in a mold whose cavity is substantially equal to the size and shape of the cavity of the tire casing in which said tube is intended to be used.
<sup>3</sup> to the point where it is fully expanded but under substantially no tension. In other words, it is inflated to about the size it will have when it is placed in use (R. 355, col. 1, lines 21-25).	<sup>4</sup> Wallace discloses "a partially cured ordinary inner tube" (R. 400, col. 1, line 13). In the contemporaneous art "Standard (ordinary) tubes * * * are only about two-thirds the size of the tire casings inside" (R. 418, col. 1, lines 29-32).
	<sup>5</sup> with only a relatively light pressure, to give it the desired size and to constitute it a suitable working or building surface (R. 400, col. 1, lines 30-33).

with the process claim in suit, the elements or portions of elements in bold face represent features claimed by the patent in the prior art patents, which the Weber disclosure or process claim in suit has eliminated.

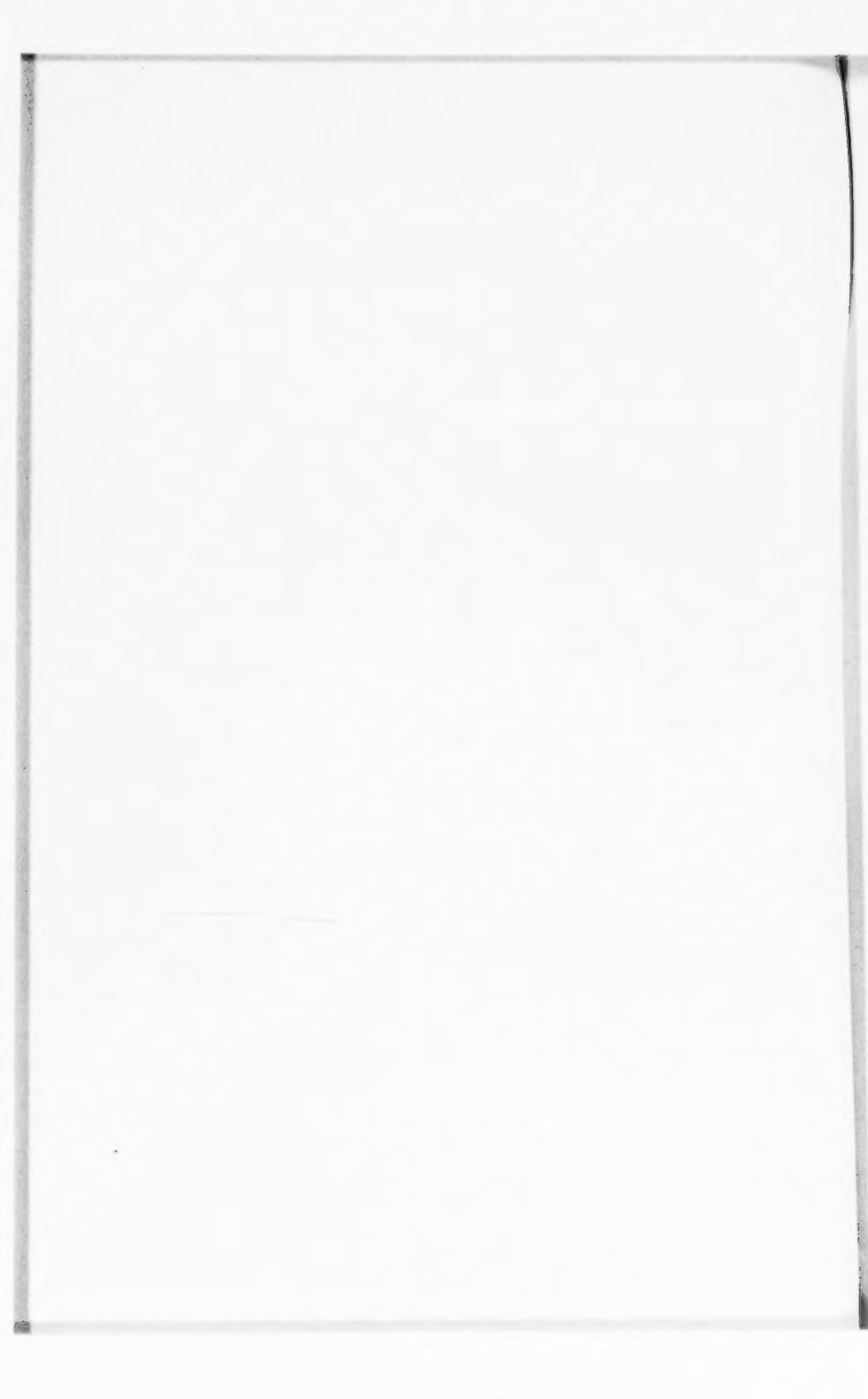
APPENDIX A

CROMBIE PATENT No. 1,350,117 (R. 412)  DISCLOSURE	WILDMAN PATENT No. 1,601,013 (R. 428) (First Method)  DISCLOSURE	WILDMAN PATENT No. 1,601,013 (R. 428) (First Method)  DISCLOSURE	WILDMAN PATENT No. 1,601,013 (R. 428) (Second Method)  DISCLOSURE
The method of making an inner tube for pneumatic tires which consists in	The method of making an inner tube for pneumatic tires which consists in	The method of making an inner tube for pneumatic tires which consists in	The method of making an inner tube for pneumatic tires which consists in
(1) forming an <b>endless</b> tube of vulcanizable rubber whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used,	(1) forming an <b>endless</b> tube of vulcanizable rubber whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used ( <i>on a straight mandrel</i> ),	(1) forming an <b>endless</b> tube of vulcanizable rubber whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used ( <i>on a straight mandrel</i> ),	(1) forming an <b>endless</b> tube of vulcanizable rubber whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used ( <i>on a straight mandrel</i> ),
(2)a <b>expanding</b> said tube by internal pressure, (2)b applying to the outer circumference of said tube while <b>inflated</b> a layer of plastic sealing compound,	(2)a <b>expanding</b> said tube by internal pressure, (2)b applying to the outer circumference of said tube while <b>inflated</b> ( <i>while on the mandrel</i> ) a layer of plastic sealing compound,	(2)a <b>expanding</b> said tube by internal pressure, (2)b applying to the outer circumference of said tube while <b>inflated</b> ( <i>while on the mandrel</i> ) a layer of plastic sealing compound,	(2)a <b>expanding</b> said tube by internal pressure, (2)b applying to the outer circumference of said tube while <b>inflated</b> ( <i>while on the mandrel</i> ) a layer of plastic sealing compound,
(3) covering the said compound with a layer of vulcanizable rubber  which extends beyond the edges of the compound and contacts with the <b>endless</b> tube for adhesion thereto,	(3) covering the said compound with a layer of vulcanizable rubber  which extends beyond the edges of the compound and contacts with the <b>endless</b> tube for adhesion thereto,	(3) covering the said compound with a layer of vulcanizable rubber  which extends beyond the edges of the compound and contacts with the <b>endless</b> tube for adhesion thereto,	(3) covering the said compound with a layer of vulcanizable rubber  which extends beyond the edges of the compound and contacts with the <b>endless</b> tube for adhesion thereto,
(4) ( <i>after which the whole is constructed to form a tube</i> ) <sup>6, 7</sup>			(4) ( <i>stripping said tube from the mandrel and joining the ends together by splicing and cementing steps</i> ) <sup>6, 8</sup>
(5) and curing the entire tube structure in a mold whose cavity is substantially equal to the size and shape of the cavity of the tire casing in which said tube is intended to be used.	(4) and curing the entire tube structure in a mold whose cavity is substantially equal to the size and shape of the cavity of the tire casing in which said tube is intended to be used.	(4) and curing the entire tube structure in a mold whose cavity is substantially equal to the size and shape of the cavity of the tire casing in which said tube is intended to be used.	(5) and curing the entire tube structure in a mold whose cavity is substantially equal to the size and shape of the cavity of the tire casing in which said tube is intended to be used.
	(5) ( <i>and stripping said tube from the mandrel and joining the ends together by splicing and cementing steps</i> ) <sup>6, 8</sup>	(5) ( <i>and stripping said tube from the mandrel and joining the ends together by splicing and cementing steps</i> ) <sup>6, 8</sup>	
<sup>7</sup> R. 413, lines 51-52.	<sup>8</sup> R. 430, lines 51-53.	<sup>8</sup> R. 430, lines 51-53.	<sup>8</sup> R. 430, lines 51-53, also appendix B. <sup>9</sup> R. 430, lines 52-71, Opinion R. 469, also appendix B.

<sup>6</sup>The specifications of the patent in suit pertinently state: "In manufacturing puncture healing tubes I have heretofore attempted to build them on a mandrel or core and then splice the ends which has produced very unsatisfactory results due to the difficulty of making the splice" (R. 355, lines 45-49). "In the present method of manufacture these difficulties are entirely overcome and the puncture healing material and outer elastic cover are regularly and uniformly placed about the tube. Also the puncture healing material and outer elastic cover are regularly and uniformly placed about the tube. Also built up before the tube is vulcanized, a tube which is without splices, seams or appreciable overlaps is formed" (R. 355, lines 63-70).

nt in suit, but lacking in the prior art patents, while the elements or portions of elements in italics, and

ments or portions of elements in italics, and



## APPENDIX B.

**Excerpts from the file wrapper of Wildman Patent No. 1,601,013 (R. 428-430, Plaintiff's Exhibit 19).**

The application as filed incorporated the following language between lines 23 and 24, R. 429, of the issued patent:

"Fig. 2 is a diagram of the tube as it appears in cross section preliminary to vulcanization. Figs. 3, 4, 5, 6 and 7 are separate reduced views of the five plies wrapped thereon and upon each other according to my present conception and practice. Fig. 9 is a side view of a segmental portion of the tube, partly in section, showing the mode of splicing the ends of the tube preliminary to vulcanization. Fig. 10 is a sectional view of a mold and an inflated tube therein prepared for vulcanization" (File wrapper, Plaintiff's Exhibit 19. The figures herein referred to appear at R. 305, 307.).

Instead of lines 14-16, R. 430, of the issued patent, the original application stated:

"In building up a tube from sheets and strips of rubber of the different compositions described I may use a round or ovate mandrel 6 and\* begin by wrapping the thin sheet or ply of free stretching rubber 1 thereon until the opposite edge portions either abut or overlap as shown in Figs. 2 and 8. The length of this sheet may be approximately equal to the internal diameter of the tube to be produced.\* (As a second step I may lay or superpose the thicker strip or ply 2 of rubber which is more resistive to stretch upon the tread side of wrapped ply 1. The width of strip 2 may be such that it will overlap the sides of the tube and mandrel more or less, and the length of the strip is slightly less than sheet or ply 1 to permit the ends thereof to be retired in respect to the ends of said first ply 1 when overlaid thereon as shown in Fig. 8.)\* The next step consists in placing the relatively thick filler strip 3

\*Step (1)

\*Omitted  
Step

\*Step (2)

of raw non-vulcanizable rubber upon the layer strip 2, and the border faces or edges of strip 2 may be left exposed. The length of filler strip 3 may also be somewhat shorter than layer 2 to permit a stepped formation to be produced at the corresponding ends of the superposed strip.\* (The next step involves the placing of a still shorter strip 4 of rubber which is strongly resistant to stretch upon raw rubber strip 3, and the width of strip 4 may be such as to completely enclose the raw rubber strip and overlap the exposed border portions of strip 2.)\* Then a thin sheet or ply 5 of free stretching rubber is wrapped around the other plies as built up or assembled, and a double or overlapping fold may be made in this ply 5 which may extend around and completely envelop and intimately contact the lower half of the first ply 1 of free stretching rubber, thus making three thicknesses or plies of the same composition of rubber in this part of the tube. The length of outer ply 5 may be less than ply 4 to expose the ends of the latter, and permit an overlapping piece of rubber to envelop the same, which together with other pieces or parts, may be vulcanized in situ to effect an inseparable union of the opposite ends of the tube as will hereinafter more fully appear. In building up the tube of plies of different inherent characteristics and properties, it should be observed that there is a lesser percentage of crude rubber used in plies 2 and 4 than in the inner and outer plies 1 and 5.

\*Omitted  
Step

\*Step (3)

\*Step (4)

\*The next proceeding involves the stripping of the built up tube from the mandrel and joining of the opposite ends together to form an endless tube. This may be accomplished by bringing the opposite ends of the inner ply 1 together and applying short sections or filler pieces 7, 8 and 9, respectively, of different lengths upon the exposed stepped portions of plies 1, 2 and 3, and wrapping them within an outer sheath 10 so that the joint or spliced portion of the tube will correspond in thickness and contour to the remainder of the tube. Moreover, the short filler pieces and outer



sheath are each of the same thickness and mixture of materials as the plies and strips of which they form a continuation, so that the completed tube will possess the same characteristics and properties throughout or in all cross sectional portions thereof.

The annular tube T composed wholly of rubber of the several compositions described, is also provided with a metal inflating valve, which is affixed to its inner circumference where an opening is formed to receive it.\* Then the tube is placed within a sectional vulcanizing mold M of circular form with the inflating valve projected therefrom and accessible to permit attachment of a tubular air connection A, whereby the tube may be inflated and expanded by air pressure against the walls of the mold cavity. Vulcanization takes place by heat, usually steam, applied to the mold, for example, in the way commonly practiced with a tire vulcanizing press, while the tube is inflated and pressed against the walls of the mold cavity by an internal air pressure. In this proceeding, all the plies of rubber, except the raw unvulcanizable strip 3, will be properly vulcanized in approximately forty-five minutes with thirty pounds of steam. The self-sealing mixture" (File wrapper, Plaintiff's Exhibit 19, pages 5-7. The figures herein referred to appear at R. 305, 307).

\*Step (5)

Instead of line 55, R. 430, of the patent as issued, the application stated:

"molding the tube in the way described herein. That is to say, the finished tube may be given the same true circular" (File wrapper, Plaintiff's Exhibit 19, page 8).

Note: The steps numbered (1) to (5) above are those steps which are set up under the same numbers below the graphically described "SECOND METHOD" OF WILDMAN, RIGHT HAND COLUMN, APPENDIX "A." The steps marked "omitted step" in parenthesis are those steps the omission of which the Circuit Court of Appeals said "WABER CANNOT ESCAPE ANTICIPATION" (R. 470).

## APPENDIX C.

Remarks of Representative Jenckes (in charge of the passage in the House of the 1870 Codification of the Patent Laws), delivered April 21, 1870, reported in 93 Congressional Globe 2877-2879:

“Mr. Speaker, there are some general considerations upon the subject of the patent laws which I wish to present to the House before asking a vote upon the passage of this bill.

The Patent Office was constituted not only for the purpose of granting patents for meritorious inventions but for the protection of the public against spurious inventions—the unjust claims of speculators trading in inventions. Hence the employment of a corps of skilled examiners and the careful investigation of the merits of each particular application for a patent.

This constitution of the office has two results. It causes the rejection of the worthless and fraudulent claims, now about one out of four, five thousand out of twenty thousand in each year; and it also enhances the value of those that are allowed and granted, giving them weight as evidence in all courts and controversies.

Recognizing the value of inventions to the State, and the want of technical knowledge and of skill in the use of language on the part of inventors, our patent laws have provided for the most tender and careful consideration of the cases stated in the petitions of inventors. They are first referred and considered by a primary examiner in the class to which the invention belongs. If he rejects the claim for want of novelty he must give the references to prior inventions upon which his decision is based, and the applicant is entitled to a second hearing before this

examiner, and to make any modification of his claim that he thinks right and proper. If he is again rejected he may appeal from the decision of the examiners to the board of examiners-in-chief, officers selected for their legal and scientific knowledge, appointed by the President and confirmed by the Senate, and if their decision should be adverse he may again appeal to the Commissioner in person. There are in fact three appeals allowed within the Patent Office. But notwithstanding all these hearings, original and appellate, the adverse decision to the petition may still be wrong. If so, how shall it be revised? This has been one of the most serious questions presented to the committee. The present law allows a proceeding in the nature of an appeal from the adverse decision of the Commissioner to either of the judges of the supreme court of the District of Columbia. But the judge in such case does not act as a court; he is merely a supervisory commissioner *pro hac vice*, and if he reverses the decision of the Commissioner and allows the patent, his decision has no weight as a judicial authority, but the patent thus obtained has less weight in the courts than one granted by the office, as it has the judgment of the several scientific tribunals within the office against it, merely the opinion of an unskilled person, although a judge, in favor of it. This is a proceeding without analogy in any other Department of the Government, and is a wide departure from the principles upon which the Executive Departments and their bureaus were constituted, and the result has been to disturb and render inharmonious the decisions of that bureau, which of all others should be most consistent and symmetrical. On the other hand, if the claim as asked for is passed by the primary examiner there is no provision for a review of his decision within the office, and the public may be made to suffer from his ignorance or indolence

in allowing without proper scrutiny the most broad and comprehensive claims.

That there should be a supervision over the action of the office is conceded, and the real question is, when should that supervision cease to be executive merely and become judicial; when should the contested questions pass out of the executive power and come within the judicial power of the United States? Sooner or later they must all be reviewed and determined by the judicial power. The committee hold and have recommended that the action of the Commissioner should be the final action of the executive power and of the incidental *quasi* judicial powers included within the exercise of his discretionary power by the head of any Department, and shall be conclusive as to all matters within the executive power, and that if his decision is sought to be reviewed, it shall be by the courts charged with the exercise of the judicial power of the United States, and upon questions within that judicial power.

These are the reasons for the amendments recommended by the committee, enlarging, defining, and making clear the remedies in the courts. These amendments reject the so-called appeal from the Commissioner to a single judge, acting as commissioner *pro hac vice* in each case, and provide for proceedings in the courts of the United States, by which the final action of the Patent Office can be reviewed judicially and with effect.

Into this forum every contested case must come sooner or later, and it is for the interest of every litigant that the proceedings should be without unnecessary delay or expense, and be as complete and conclusive as they can be made. It may not strike the ear as a perfectly plain or self-evident proposition, but I can say from personal experience that it is nevertheless true that the remedies in equity in the courts of the United States, under the

rules established by the Supreme Court, are the most speedy, the least expensive, and the most satisfactory of any known to the law. It is within this jurisdiction that we recommend that all these controversies should be brought and determined. The questions that arise in these controversies are subtle, not easy to understand, and difficult of determination. They arise out of the exercise of those powers of the mind which have added and which are constantly adding to the development of the material prosperity of the human race.

Patent laws are based upon the belief that the field of the useful arts may be extended, and that many things which may add to the comfort, the well-being, and the prosperity of mankind yet remain to be discovered. These laws give to every one who thus by his inventive genius adds to the sum of human knowledge in either of the ways indicated, a protection for a few years to the exclusive use of his invention or discovery. They offer a premium upon the exercise of this talent for the benefit of mankind. They recognize a man's right to the fruit of his own mind, upon the condition that he shall teach the public how to use his invention without price forever after the termination of the period for which his use is exclusive. Property in ideas, and protection to that property for a limited period, is the vital principle of these laws. If he who can teach us how to make two blades of grass grow where but one grew before is a public benefactor, how much more so is he who constructs for us a machine or explains to us a chemical process by the use of which one man can bring about a greater and more perfect result than a hundred men could do before? This is the domain of invention, and so far as it is genuine the law follows it with its protection for seventeen years.

But why protect it at all, say many. If an invention had

not been perfected by this patentee today it would have been at some subsequent time by some other inventor. Why not wait and let it be produced in course of time, according to the necessities of the art in which it is developed, and without expense to the public? This objection touches precisely the point of the whole matter, and affords the best argument for the patent laws. It admits that invention is a question of time, and that the results of invention are desirable and valuable. The patent laws offer a premium upon the earliest time. If it be known that any art or manufacture could be improved by invention in any particular, the question is, is it likely that such improvement will be made sooner by protection of the inventor, or will it be delayed indefinitely without such protection? The solution of this question does not rest in speculation. The history of inventions determines it. The loom is as old as civilization, but the power-loom was perfected under the stimulus and protection of the patent laws. So was the machinery for spinning. The philosophy of steam may have been ancient, but the steam-engine is a creature of the patent laws.

These are but individual instances. They might be increased till the mind and memory would be burdened by the catalogue. The assurance that thought, skill, and inventive talent may gain fame, honor, and fortune, by an early solution of the problems in science and art that are pressing upon us, brings into the enjoyments of this age improvements and discoveries that might not have been known for centuries later. The theologians will not admit that any new developments or discoveries can be made in religion; the politicians have not advanced much in their arts beyond those we read about in ancient history; in the fine arts the greatest genius of the present day can hardly hope to excel "the old masters;" in architecture nothing has been produced within the last five hundred years to

surpass that which has been known, admired, and reproduced for twenty-five hundred.

The sphere, therefore, in which original genius and inventive talent can best obtain recognition, honor, and reward is that of science and the useful arts. Therein, under the protection and fostering care of laws like that which we now reproduce, has been the greatest progress of the world within the last century, and in many branches of these arts the progress has been greater within the memory of living men than in the entire previous historic period. As the desires and necessities of mankind are the same in all generations there must be some reason why this advancement is found in the nineteenth century instead of in the ninth, or the tenth, or in any of those centuries which are mere barren wastes in the history of civilization. Certainly one reason is because there is some incentive in this era for the development of improvements in this sphere. It cannot be found in the necessities and desires of the race alone, for those have been always the same; and those who have ministered to their wants and necessities, with the means known to previous generations, have been the most strenuous opponents of the introduction of these new inventions.

It is not true, as argued by one of the most illustrious of the opponents of the patent laws in our time, that manufacturers will welcome and adopt an invention which seems to be called for by the necessities of their particular manufactures. This has never been the case where the profits of capital and labor have been disturbed by a new invention which created a revolution in a particular art or manufacture. "It may seem a paradox," says a distinguished author discussing "the rights and wrongs of inventors," "but it is no less true, that inventors' patrons are among their most inveterate opponents." The inventor of the machine for making paper, Fourdrinier, was driven out of

France, and it took him ten years to introduce his machine into England in opposition to the methods of paper-making by hand. The inventor of the loom for weaving variegated patterns in fabrics, Jacquard, was in danger of his life from his collaborators in Lyons, and the capitalists and artisans, whose money and labor were dependent upon the use of the old looms for their profits, fought for years against the introduction of the revolutionary invention. The conflict is still recognized in our tariff laws. In our own country we know of the opposition to the steamboats, the locomotives, the mowing and reaping machines, the sewing-machines, the revolutionary inventions in the manufacture of carpets, paper, iron, and steel. In no case does the capitalist welcome an invention which requires him to reconstruct or lay aside the machinery used in the manufacture from which he derives a profit, nor is it looked upon with favor by the laborers, nine out of ten of whom it threatens to throw out of employ.

The necessities of any art or manufacture do not prompt invention. The conservative tendencies both of capital and labor array themselves against it. The inventor is more frequently than otherwise disconnected with the trade or manufacture to which his invention applies and from which he seeks his reward. But the necessities of the public, the consumers of the product of the art and manufacture, all the time demand improvement and increased cheapness. The premium to inventors by the limited protection of the patent laws is thus directly in the interest of the public. When it is said that an invention would have been made at some time if not at the time when it was made, without the stimulus of the patent laws, who can tell at what time? When would any modern invention that might be named, the sewing-machine, for instance, have been produced if the inventors had not expected a profit upon it?



What invention can be named which this generation would willingly have parted with and consented to have postponed till the next century by reason of the extravagant price we have paid for it under the patent laws, whose stimulus and protection have caused it to be made in our time? Would we, then, part with the cotton gin, the locomotive, the steamboat, the electric telegraph, the sewing-machine, the cast-iron plow, the reaper, the machines for gathering the hay crop, the planing machine, the improved steam-engine, the rotary printing press? I have mentioned only those inventions which are embodied in wood and metal. But for the small consideration which the inventors or those working the inventions have received would we have parted in our time with vulcanized rubber and its thousand uses; with illuminating gas; with all the arts of dyeing and printing, which have extracted from waste weeds and the refuse of the gas factories the colors which vie with the Tyrian purple; with the wonders of the lithographic and photographic arts; and with all those wonderful substances, with almost magic properties, which are the products of chemistry as applied to the arts? I challenge a reply from the most bigoted opponent of the patent laws.

These inventors have been questioning nature, and her kind responses have been a benefit to themselves as well as benefactions to mankind. But while the law has encouraged them, capital, from its conservative instincts, has always been opposed to them. Those who have invested their means in the machinery and apparatus which is well known and in common use in any particular branch of manufacture do not like to be confronted with an inventor who can demonstrate that he can produce the articles manufactured in a better and cheaper manner by a method which requires new investments of capital and makes the old apparatus comparatively worthless. The manufacturers of the old

musket did not welcome the inventors who brought them the breech-loader and the magazine rifle, requiring new tools for their construction and consigning the old to the scrap heap.

Invested capital would never encourage or adopt new and revolutionary inventions. It would be a benefit to all now engaged in manufactures if no new improvement was made in their machinery for twenty years, or until it was worn out. They would be saved the cost of making the changes required by the new invention. There is a historical anecdote which illustrates perfectly the relative position of the capitalist who believes that he has assured possession of the art in which his capital is invested and the inventor whose invention would render those investments of little value. It is a remarkable incident in the history of the lost arts, preserved in the curious gossip of Petronius:

“A certain skillful workman used to make crystal vases as strong as vases of gold and silver. He produced an incomparable masterpiece. It was a chalice of astonishing beauty, which he thought worthy of Caesar only, and which he felt a pride in offering to him. Tiberius highly praised the skill and the rich present of the artist. This man, wishing to increase still more the admiration of the prince, and secure his favors to a greater degree, begged of him to give back the vase. He then threw it with all his might on the marble pavement of the apartment; the hardest metal could never have resisted this terrible shock. Caesar appeared moved, and was silent. The artist, with a triumphant smile, picked up the vase, which had only a slight dent, and which by striking it with the hammer was soon brought to its original state. This being done, no doubt remained in his mind that he had conquered the good graces of the Emperor and the esteem of an astonished court. Tiberius asked him if he was the only one who knew how to work crystal in so remarkable a manner. The workman immediately answered that no one possessed the secret. ‘Very well,’

said Caesar, 'let his head be struck off without loss of time; for if this strange invention were known gold and silver would very soon have not the least value.'

"Thus did the Emperor Tiberius encourage artists and the arts."

And in the same way do our manufacturing capitalists encourage inventions and inventors. They unconsciously imitate Tiberius, and although they cannot, like Caesar, strike off the impertinent inventor's head, they too often have turned him off to starve. But under our patent laws, as they were established in 1836, the inventor, if he be prudent and thrifty, is assured of a certain compensation. Under the existing constitution of the Patent Office, its seal is evidence that its possessor is entitled *prima facie* to a new and useful invention. The number of persons skilled in the useful arts, and the business to which they appertain has largely increased. There are many skilled persons who can estimate with approximate correctness the value of every new invention. Under this American system of patents, in itself as great an invention as any that are protected by it, inventions have become commodities of marketable value. No inventor now needs to sacrifice his invention for subsistence. Some, perhaps, have anticipated the period of their greatest usefulness; but every genuine invention now has its value, a great portion of which can, with ordinary care and prudence, be realized by the inventor.

Without this protection we should return to the era of "secrets," when every valuable discovery was carefully guarded by its possessor, or parted with only upon terms which required the purchaser to be equally silent and uncommunicative. The public obtained no useful knowledge of the art and but a limited advantage from the working of the discovery. The evil consequences of that system

were twofold. The knowledge of many valuable inventions and discoveries died with their possessors and are now among the lost arts; on the other hand, empirical processes of fictitious value were imposed upon manufacturers under the guise of "secrets" in the arts, and the whole subject of invention and the character of inventors became discredited and debased. The injury to the progress of the useful arts by these pretended secrets has been greater a thousandfold than any that has arisen from the abuse of even the most imperfect system of patent laws.

Now every invention published through the Patent Office adds something to our knowledge, and, if useful, increases the material wealth of the world. And I do not hesitate to say that the sum of these values, the aggregate increase to the wealth of this country, from the inventive genius of the people fostered and protected by the patent laws, has been greater than that derived from all the protective tariffs passed since the Government was organized under the Constitution. A protective tariff deals only with the known elements of labor and skill; as with cottons produced in this country with the same machinery, labor, and skill as they are produced in England and France, and with iron as produced in Scotland or Wales. But invention takes a stride forward of the known mechanism and processes, and calls for a higher degree of skill. Who can estimate the effects of the invention of the cotton gin upon this country? Not its value in money merely, but its effects socially, morally, and politically? Consider the results from the leading inventions I have named, and see how small are the results from the manufacture of coarse cottons and pig iron when compared with the great interests these inventions have created in the country.

The most distinguished of the opponents of the patent laws has argued in favor "of putting an end to the notion

that every person who invented anything had a right to a patent," and that "the giving of patents was a matter of grace and favor in well-selected and discriminated cases, in the exercise of a discretion, by an authority intrusted with that discretion;" and in his superlative wisdom he expressed the opinion that "at the period of progress in the history of the arts and trade at which they had arrived they could do much better without these props. He called them props because they were meant to be so, but he believed that at present they were nothing but obstructions and hinderances to trade and the arts." This was said of the patent laws of Great Britain, where there is no preliminary examination and investigation into the rightfulness of the inventor's claim, but where any one can take a patent by paying the fees, if he claim to be either an inventor or the person who first introduced an invention into that country.

Our American system of patent law defies such narrow, carping, illiberal, and unjust criticism. It acknowledges and declares that the first and original inventor of anything new and useful has a vested right to its protection by a patent for a limited term, upon the compliance by the inventor with certain mild and prudent conditions. It provides for a discrimination which shall determine what the invention is, not as a matter of grace and favor, or in the exercise of an uncontrolled discretion, but as a matter of right as between the inventor and the public. It is not based upon the idea that invention has reached its highest flood, and must soon be subject to a returning ebb; or if the results of invention be likened to a structure, it does not consider that it is now complete and perfect, finished and furnished, and that the "props," which the patent laws were, may now be knocked away; nor does it consider that these laws are obstructions and hinderances to trade and the arts.

Under the beneficent provisions of these laws the results of the inventive genius of our people have developed, and are now being developed, in almost geometrical progression. Never at any time in the history of the world have so many and so valuable inventions been made known through the Patent Office. The inventors of all nations seek this country for the protection of its laws. Every invention thus acquired, as well as any now produced at home, is the planting of a new industry which needs no other protection from legislation, to grow and prosper than that which is afforded by these laws. The rise of this inventive genius is not like that of the tide which must reach its limit and recede, but like the increase and swelling of a river, which will not diminish while its course, which is that of time itself, shall continue.

There is nothing of which this nation may be more justly proud than its progress in the industrial and useful arts. No greater and more beneficial results to mankind have been attained in the whole history of the race than have been accomplished within the last three quarters of a century and in this country. If we look back over the whole history of invention we are surprised to see how meager and barren it is, compared with what has been achieved almost within our time. The country acknowledges always this great glory which its citizens have acquired. The nation takes pride in the record of the results of that inventive genius which is preserved in one of the grandest temples ever dedicated to art and science by any nation or in any age; and it knows that great as is its renown in arms, in the spread of liberty, and in the success of free government, there is no brighter coronal that adorns the Republic than that which is enwreathed from the contributions of its inventors to science and the useful arts."







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IN THE  
**SUPREME COURT OF THE UNITED STATES**

OCTOBER TERM, 1944

**JAMES W. WABER,**

Petitioner,

VS.

**MONTGOMERY WARD & CO., INCORPORATED,**  
**and UNITED STATES RUBBER COMPANY,**  
Respondents.

On Petition for Writ  
of Certiorari to the  
United States Circuit  
Court of Appeals, for  
the Seventh Circuit.

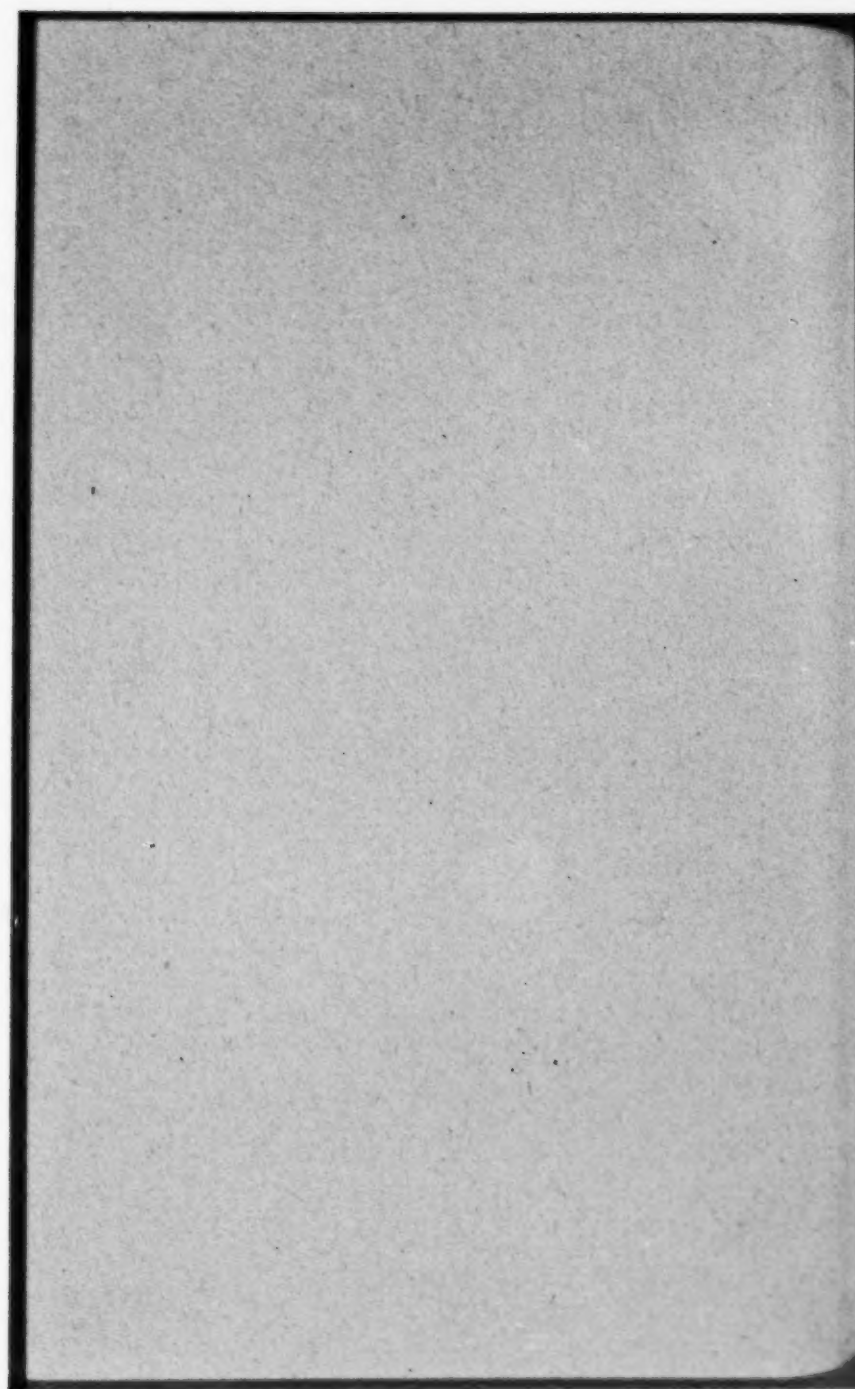
**BRIEF OF RESPONDENTS IN OPPOSITION  
TO PETITION FOR CERTIORARI.**

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BRIEF OF RESPONDENTS IN OPPOSITION  
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STATEMENT OF THE CASE.

To correct inaccuracies and omissions in petitioner's *Statement of the Case*, respondents submit, under Rule 27, paragraph 4, the following corrections and additions to petitioner's *Statement of the Case* (Br. 14-19) which includes, by reference, petitioner's summary and short statement of the matter involved (Br. 2-6).

Petitioner's statement is inaccurate that "the Circuit Court of Appeals found only three [of the prior art patents] to be pertinent" (Br. 4). What the Court of Appeals found was that Wallace, Crombie and Wildman (1,601,013) were "the most pertinent" of the prior art patents (R. 467).

None of these three "most pertinent" prior art patents was cited in either Waber application.

Petitioner's statement is inaccurate that "The Court of Appeals found that two of the four [Waber] steps were not disclosed in Wallace" (Br. 4). The Court of Appeals, in fact, found that Wallace disclosed all of the four steps of Waber, "the only difference" (R. 468) being in "the nature of the intermediate layer" (R. 468) used in one of the steps and that this substitution of material (R. 468) involved no substantial change in the method (R. 468) and did not, under the cited authorities, constitute a difference in method (R. 468).

Petitioner's statement is inaccurate that the Court of Appeals, "ignores that the dimensions of the base tube of 'Waber are slightly smaller than the cavity in the tire casing in which said tube is intended to be used'" (Br. 16). It is believed also inaccurate, at least in significance, and particularly in view of the Court's actual conclusion with respect thereto, to state that "The opinion of the Circuit Court of Appeals *specifically states\** that a feature of Waber's invention is that Waber forms an 'inner tube' of predetermined size" (Br. 15). The Court of Appeals in its opinion merely quoted from the Waber patent where Waber himself said "A feature of my invention \* \* \* is an inner layer \* \* \* formed of a predetermined size" (R. 465).

On the contrary, the Court of Appeals considered particularly this matter of size. It compared the base tube of Wallace with that of Waber and, having previously noted that Waber's base tube "resembles the ordinary inner tube," (R. 466) pointed out, first, that Wallace's process also "starts with an ordinary inner tube" (R. 467). The Court then suggests that while Wallace "does not explain

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\*Emphasis ours throughout unless otherwise indicated



the "relative size and shape" of this tube (R. 467) he does state it is *inflated* to give it the *desired size* "so as to constitute a suitable working or building surface while the tube or tire is being built" (R. 467) and concludes that the Wallace and Waber processes thus far "are substantially, if not precisely, the same" (R. 467).

The Court of Appeals thus actually considered the very feature that petitioner contends it "ignored" and the Court concluded that Waber's contended "predetermined size" could not be and was not a feature of invention.

Petitioner's statement with respect to the Wildman patent at the bottom of page 4 of its brief is also inaccurate, not only in significance, but also in fact.

It is inaccurate in significance because the quoted extracts "language is not entirely clear" and "assuming, as we think we must," (Br. 4) have a different significance in the full context in which they occur than that which petitioner imparts to them here.

It is inaccurate in fact as the Court of Appeals did not state that the "language is not entirely clear" was *the anticipating* (Br. 4) language as petitioner indicates, nor did the Court of Appeals predicate its "assuming, as we think we must," statement on its "language is not entirely clear" comment by tying them together with a *but nevertheless* or equivalent connecting link as petitioner has indicated (Br. 4).

Petitioner omitted to indicate in this connection that the Court of Appeals, having already found that Wallace disclosed all the Waber process steps and that the "only difference" in the processes was in "the nature of the intermediate layer" (R. 468) first remarked that "Wildman contemplated *in the main* \* \* \* building \* \* \* on a straight pole mandrel" (R. 469), then referred back to Wallace and said that Wildman:

"shows an intermediate plastic layer designed for the same purpose as that of Waber and by which, as already pointed out, Waber attempts to distinguish his disclosure from that of Wallace." (R. 469),

and then continued in full as follows:

"But more than that, Wildman also suggests in his specifications:

"\* \* \* but less operations are required and certain advantages accrue in molding the tube of the same true circular shape as the casing and also a shape corresponding exactly to the cross section of the cavity or inner walls of the casing \* \* \*."

"While this language is not entirely clear, we are inclined to agree with the defendants in their contention that Wildman was referring to an inflated inner tube to which the additional plies were to be added on the tread side. This view is strengthened by Wildman's further statement:

"\* \* \* in making the tube in this way the inner and outer plies 1 and 5 may be shaped while the rubber is in an unvulcanized state and adapted to be readily fitted to the mold to produce a wall of uniform thickness without buckles or folds at the inner circumference of the tube \* \* \*."

"Assuming, as we think we must, that Wildman discloses a process by which additional plies could be constructed on an inflated inner tube, we are of the view that Waber is also anticipated by Wildman." (R. 469, 470).

## ARGUMENT.

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### Summary.

The argument starts with a comparison of petitioner's case as presented in section 1 of its brief, with the two jurisdictional cases relied upon therein by petitioner. It is argued that in this case there is neither such concentration of industry nor any possible domination thereof which determined jurisdiction in the two relied-upon cases. It is also urged that petitioner's case is not sufficiently strong to warrant setting aside the concurrent findings of the two lower courts.

Question 1 is next considered and section 2 of petitioner's argument. It is urged, first, that petitioner challenges the established fundamental requisite of invention and is seeking to change this established requisite by judicial interpretation unsupported by legislative enactment. It is argued also that the proposed question has been previously considered and authoritatively settled affirmatively and that there is no conflict of opinion with respect thereto.

Question 2, and the Wallace patent, to which section 3 of petitioner's argument pertains, is next considered, and it is argued that there is no basis in the Court of Appeals' opinion for question 2.

Question 3, and the Wildman patent, to which section 4 of petitioner's argument pertains is next considered, and it is argued that the Court of Appeals opinion does not state nor signify the interpretation asserted by petitioner. It is argued specifically that the Court of Appeals in finding Waber anticipated by Wildman did not rely on "language not entirely clear" nor improperly assume what it did assume in its finding of such anticipation.

Question 4 and sections 5 and 6 of petitioner's brief pertaining thereto are next considered. It is argued, first, that the authorities do not substantiate petitioner's characterization of Wallace, Crombie and Wildman either as "paper" patents or "abandoned," and, secondly and separately, it is argued that petitioner's proposed "objective tests" are not "established tests," and that the Court of Appeals did consider the Waber invention objectively in so far as any of petitioner's proposed "objective tests" could be persuasive.

## PART I.

### Necessary Certiorari Requirements Lacking.

This being a patent case in which the Courts below concurred in holding the patent invalid, and there having been no conflict of decisions in different circuits, petitioner, as is indicated in *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U. S. 251, 258, is entitled to a writ of certiorari only if the case is of peculiar gravity and general importance.

Under these circumstances, petitioner, relying on *Schriber-Schroth Company v. Cleveland Trust Company*, 305 U. S. 47 (Br. 22) and *Muncie Gear Works, Inc., et al. v. Outboard, Marine & Manufacturing Co., et al.*, 315 U. S. 759 (Br. 23) represents that "the entire industry, except for respondents' infringing acts, is now concentrated within the Seventh Circuit" (Br. 22) and that by reason thereof "it is unlikely that there will be a conflict of decision resulting from litigation elsewhere." (Br. 20).

In both the *Schriber-Schroth* and *Muncie Gear Works* cases, however, the patent or claims thereof had been sustained by the Court of Appeals. Thus, since the industry was concentrated in the Circuit where the patent was

sustained, the entire industry was subject to domination without any opportunity for review otherwise than through the granting of a writ of certiorari by this Court. Such was the peculiar gravity of those cases. In the present case no such situation is present.

Moreover, while the patent in the *Schriber-Schroth* case involved a gas engine piston designed to prevent or restrict undue expansion (305 U. S. 51) the sustaining of the patent was considered to affect the automobile industry, and while in the *Muncie Gear Works* case the patent involved an "anti-cavitation plate" (315 U. S. 760) the sustaining of that patent was considered to affect the out-board motor industry. Such was the general importance of that case.

No industry or concentration of industry such as contemplated in the *Schriber-Schroth* and *Muncie Gear Works* cases or comparable thereto is involved in the present case. In fact there is merely the patentee's own business and "possible manufacture by the respondent, United States Rubber Company" (Br. 10).

It is noteworthy also in this connection that in a potential market of 35 to 40 million tubes a year (R. 470) Waber, during his peak year (R. 470) of 1941 (R. 31), almost ten years after his patent was granted (on June 2, 1931) (R. 353), sold only something like 100,000 tubes (R. 470).

Accordingly, this case is of no such general importance or peculiar gravity as contemplated in the *Schriber-Schroth* and *Muncie Gear Works* cases, and these cases, which petitioner relies on, afford no support for the present petition.

Moreover, no substantiated question of law is presented here. Only a proposal by petitioner to change the existing established law. This is petitioner's so-called "ultimate question" (Br. 6).

There is no judicial disagreement or conflict with respect to the matter presented in this ultimate question and no decision has been cited or referred to to this effect. In so far as it is a question as to which there is judicial disagreement, it is purely imaginary.

Petitioner seeks to bring in under this ultimate question as "subordinate questions," (Br. 7) matters of fact (*Thomson Spot Welder Co. v. Ford Motor Co.*, 265 U. S. 445, 446). This Court does not grant a certiorari to review evidence and discuss specific facts (*United States v. Johnston*, 268 U. S. 220, 227).

Moreover, the lower Courts' findings herein are concurrent. As indicated in *Goodyear Tire & Rubber Co., Inc. et al. v. Ray-o-Vac Company*, 321 U. S. 275, 278, it must be a strong case in which this Court will set aside the concurrent findings of two courts. No strong case is presented here.

Petitioner's case and questions accordingly do not have any of this Court's announced essentials for obtaining a writ of certiorari.

## PART II.

(Question 1.)

**Was the Circuit Court of Appeals justified in holding a patent invalid upon the application of a negative test of invention that a person trained and skilled in the art by studying and understanding the prior art, could have duplicated the accomplishments of the patentee?**

The above question, which petitioner designates as "The ultimate question" (Br. 6) and in which, according to petitioner "lies the crux of the error of law made by the Circuit Court of Appeals" (Br. 5) challenges the established

fundamental requisite of invention, namely, "more ingenuity \* \* \* than the work of a mechanic skilled in the art" (*Cuno Engineering Corporation v. Automatic Devices Corporation*, 314 U. S. 84, 90) who has (presumably) "a knowledge of all preexisting devices" (*Mast, Foos & Co. v. Stover Manufacturing Co.*, 177 U. S. 485, 493) or the knowledge available, as the Court of Appeals said, "by studying and understanding this prior art" (R. 470).

This challenged requisite is indeed the "flash of creative genius" of the *Cuno* case which therein signifies the antithesis of "merely the skill of the calling" and which latter is therein recognized as not rising to the dignity of invention (*Cuno*, 314 U. S. 91).

Petitioner's contention is that the question the Court of Appeals should have answered was not whether anyone skilled in the art "could have duplicated" the accomplishment of the patentee, but whether such person "would have constructed" a puncture sealing tube in accordance with Waber's teachings (Br. 25) and in support of its suggested "would have constructed" test of invention, petitioner relies, not on any decisions or judicial interpretation, but upon an explanation of the patent system by Representative Jenckes when the patent laws were codified in 1870 (Br. 25) and the report of the late President Roosevelt's National Patent Planning Commission (Br. 21, 27, 42), neither of which has the force of legislative enactment.

In advocacy of his suggested test of invention, petitioner contends that the Court of Appeals has in effect rewritten entirely the Second Defense of U. S. Code, Title 35, Section 69 (Br. 27) and "stepped beyond the Constitution" (Br. 28), and apparently condemns the Court of Appeals for its conduct in this respect, and yet, petitioner at the same time seeks to persuade this Court to conform its own judicial interpretation of the Statute to references which have no legislative effect.

The fallacy of this contention of petitioner is evident from petitioner's own authority, *Electric Storage Battery Co. v. Shimadzu et al.*, 307 U. S. 5, relied upon by petitioner (Br. 28) to condemn the Court of Appeals, and in which this Court stated:

"We cannot thus rewrite the statute. \* \* \* Congress has not seen fit to amend the statute in this respect and we must assume that it has been satisfied with, and adopted, the construction given to its enactment by the courts."

Furthermore, petitioner's so-called "ultimate question," contrary to petitioner's contention, involves nothing "new" or "novel" (Br. 23).

In *Hotchkiss et al. v. Greenwood et al.*, 11 How. (U. S.) 248, which was specifically discussed in *Cuno Engineering Corporation v. Automatic Devices Corporation*, *supra*, because the respondent in the latter case sought to have the rule of the *Hotchkiss v. Greenwood* case relaxed, the question settled was substantially if not precisely the same as that which petitioner here contends is new and seeks to have this Court consider.

In fact, in the *Hotchkiss et al. v. Greenwood et al.* case, dissenting Justice Woodbury expressly disapproved of the rule of invention of the majority opinion because the latter contemplated that the accomplishment did not constitute invention "if an ordinary mechanic *could have made or devised it*" (11 How. (U. S.) 248, 268). These emphasized words are exactly the words of the question which petitioner seeks now to have the Court consider.

This *Hotchkiss v. Greenwood* case was followed by *McClain v. Ortmyer et al.*, 141 U. S. 419, which, although it did not refer to *Hotchkiss v. Greenwood*, adhered to and emphasized the rule of the latter case.



In this *McClain v. Ortmyer* case it was pointed out that the plaintiff therein had urged "that the only practical test of invention is the effect of the device on the useful arts" (141 U. S. 419, 427), which is substantially and fundamentally what petitioner is urging here. Commercial success, which the Court recognized as persuasive of invention in a case of doubt (141 U. S. 419, 429) was urged therein as such test of invention as it is by petitioner here. The Court, however, in that case, after considering carefully what constituted invention under the Statute, found that invention could not be determined by any such test (141 U. S. 419, 428).

In that case there was evidence of considerable commercial success,—a large demand for the patented device arose and had increased year by year (141 U. S. 419, 428). In the present case the Court of Appeals found no "widespread demand" or "substantial sales" (R. 470).

No error is claimed here (Br. 20) that the Court of Appeals failed to find commercial success. There is no commercial success on which any contentions here depending on commercial success can be predicated.

Both the *Hotchkiss v. Greenwood* and *McClain v. Ortmyer* cases have been cited and relied on many times by District Courts, Courts of Appeal and this Court.

Thus this so-called "ultimate question" of petitioner not only involves nothing new or novel which this Court has not already decided, but, moreover, the basis upon which petitioner seeks consideration of this, its "ultimate question" is contrary to this Court's own statement of its position. Also petitioner has not cited or mentioned any Court decision signifying any conflict of opinion to substantiate or warrant its question.

**PART III.**

(Question 2.)

**Does a prior art patent (the Wallace patent 1,258,506) which fails to disclose two steps of four steps of the process of the patent in suit anticipate such a patent?**

As pointed out in respondent's "Statement of the Case" on page 2 the Court of Appeals did not find that a prior art patent (Wallace) failed to disclose two steps of the four steps of the process of the patent in suit. It, in fact, found that Wallace disclosed all of the four steps of Waber.

Consequently, there is no basis in the Court of Appeals' opinion for petitioner's above-recited second question. What petitioner apparently is seeking is consideration of the fact of whether or not two, out of the four steps found by the Court of Appeals in Wallace, are in fact in Wallace.

Aside from the fact that the opinion itself of the Court of Appeals abundantly shows that the two questioned steps are actually in Wallace, this Court, as pointed out in Part I hereof on page 8, does not consider such questions.

**PART IV.**

(Question 3.)

**May anticipation be "assumed" by a patent (the Wildman patent 1,601,013) where the "language is not entirely clear"?**

This "subordinate question" is predicated, not on any error in the opinion of the Court of Appeals but upon petitioner's own erroneous assumption from selected isolated extracts from the incomplete context thereof.

As indicated in respondent's Statement of the Case (pages 3 and 4), petitioner has failed to mention or discuss in its petition or brief either the full context of that part of the opinion pertaining to this question or even essential parts thereof.

The Court of Appeals, in that part of its opinion in which it considers Wildman (R. 469, 470) points out that "Wildman contemplated *in the main* the \* \* \* building \* \* \* on a straight pole mandrel" (R. 469) then, significantly, refers back to Wallace, (R. 469) which was granted on March 5, 1918 (R. 392) and, of course, is prior art as to Wildman whose application was filed on February 15, 1924.

Wildman naturally is to be read and its disclosure construed in the light of the prior art (*Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U. S. 45, 63) of which every patentee is presumed to have knowledge (*John T. Riddell, Inc. v. Goldsmith Sons Co.*, 92 F. (2nd) 353, 356). It is not necessary for the patentee to explain in detail what is already known (*Westinghouse Electric & Mfg. Co. v. Radio Corporation*, 24 F. Supp. 933, 940). Accordingly, in construing a patent, there are some things that must be assumed.

Having already found that Wallace discloses all four steps of Waber and that Wildman "*in the main*" contemplated building on a straight pole mandrel, and that the only respect in which Waber differs from Wallace is in "the nature of the intermediate layer" (R. 468), the Court of Appeals points out that Wildman "shows an intermediate plastic layer designed for the same purpose as that by which Waber *attempts* to distinguish his disclosure from that of Wallace" (R. 469), and then quotes two passages from Wildman, *both* of which, together with *other mentioned circumstances*, of course, contributed to its conclusion that Wildman anticipates Waber.

Out of all this matter considered by the Court of Appeals in arriving at its conclusion that Wildman anticipates Waber, the only part to which the "language is not entirely clear" suggestion pertains, is just one of the Court's two quoted extracts from the Wildman patent, and as to that particular extract the Court indicates that its view thereof "is strengthened" by the other quoted extract from Wildman (R. 469).

It cannot be correctly said, therefore, as petitioner represents, and contends, that the Court of Appeals "relies upon anticipating 'language' \* \* \* not entirely clear" (Br. 32).

Also the "assuming, as we think we must" extract, which petitioner has reference to in its "Such a disclosure does not support the anticipation defense" statement, on page 4 of its brief, does not immediately follow the "language is not entirely clear" quotation in the Court of Appeals opinion (R. 469) nor does it necessarily, or even appear to, apply thereto.

It follows the *entire discussion* by the Court of Appeals of the Wildman patent, including its particular reference to the prior art patent of Wallace as disclosing all four steps of Waber, its mention that Wildman "*in the main*" contemplates building on a pole, and its significant statement that "Waber *attempts* to distinguish his disclosure from that of Wallace."

There is no indication in its opinion that in "assuming" what it assumed, the Court of Appeals *relied on* the "not entirely clear passage" of Wildman. It had a right to assume, from *other matters* mentioned in its consideration of Wildman, "that Wildman discloses a process by which additional plies could be constructed on an inflated inner tube" (R. 469).

It must be presumed, therefore, that the Court of Appeals assumed what it did, on matter from which it had *a right to assume* what it did, and especially so as there is no indication that it based its "assuming, as we think we must" statement on the "language is not entirely clear," as petitioner contends.

The facts upon which the Court of Appeals found that Waber is anticipated by Wildman are not open to consideration here.

## PART V.

(Question 4.)

**Is the Waber patent 1,808,091 valid in view of the Wallace patent 1,258,506, the Crombie patent 1,498,017 and the Wildman patent 1,601,013?**

This question presents for consideration the validity of the Waber patent rather than the invalidity thereof which the Court of Appeals actually found, this being done by petitioner presumably because objective tests, which petitioner would have applied, serve to show validity, whereas subjective tests, which it is contended the Court of Appeals erroneously relied on, serve to show invalidity.

On this question petitioner urges first, that the patents which the Court of Appeals considered the most pertinent are "paper" patents and that "its finding of invalidity thereon "is *probably* in conflict with applicable decisions of this court" (Br. 34) and secondly, that "established" tests of invention prove the patentability of the Waber contribution (Br. 37).

Respondents will discuss these two subjects separately as petitioner has done.

### A. Paper Patents.

On the matter of "paper patents" the only support which petitioner can find is (1) a very early Supreme Court observation, admittedly dictum (Br. 34), concerning the *patent in suit in that case*, wherein the device of the patent after full and fair trial resulted in unsuccessful experiments and was abandoned and (2) another early Supreme Court decision, in which the Court was discussing the *patent in suit in that case* and indicated, that that patent was, as petitioner says, "entitled to but a very narrow construction" (Br. 35) because of the particular circumstances of that case, and (3) five lower court decisions the inapplicability of which as authority on "paper patents" is exemplified by the fact that one of these, namely, *Diamond Patent Co. v. S. E. Carr Co.*, 217 Fed. 400 (Br. 36) has reference to a *prior use* and not to a patent.

Significantly and discreetly petitioner does not mention the particular circumstances in any of these cases nor attempt to show that the selected extract therefrom actually has in the case from which it is quoted the significance as to paper patents which petitioner seeks herein to have attached thereto. In fact petitioner, himself, does not even venture to draw any deduction from these cited cases. He merely quotes extracts and apparently hopes that this Court will arrive at the desired deduction therefrom.

Such veiled and unreliable representations are not sufficient to discredit prior art patents and what they disclose, especially when this Court held in *Milburn Co. v. Davis Bournonville Co.*, 270 U. S. 390, after pointing out that "publication in a periodical is a bar" (p. 400) that "the disclosure by the latter [an issued patent] would have had the same effect as the publication of the same words in a periodical" (p. 400).

Petitioner in this connection says the Wallace, Crombie and Wildman patents "were abandoned" (Br. 6). Abandonment, however, is a question of intent, (*International News Service v. Associated Press*, 248 U. S. 215, 221) and to establish abandonment "it is necessary to show not only acts indicating a practical abandonment, but an actual intent to abandon" (*Baglin v. Cusenier Co.*, 221 U. S. 580, 598). The showing herein obviously does not justify petitioner's representation that the Wallace, Crombie and Wildman patents were abandoned.

## **B. Established Tests of Invention.**

In its section "Established Tests of Invention Prove the Patentability of the Waber Contribution" (Br. 37), petitioner contends that the Court of Appeals should have tested the presence of invention by the "objective tests *enunciated by this Court throughout the years,*" but it is significant that neither in this section nor elsewhere in its brief has petitioner cited any decision enunciating any tests that petitioner proposes nor any decision which affords any basis for petitioner's characterization of his proposed tests as "established" tests of invention. Obviously petitioner has no such authority and is relying on "established tests" which do not exist.

Petitioner does refer to the Encyclopedia Britannica together with two decisions (Br. 37) under its "Established Tests" heading, but these do not enunciate nor are they cited to show any established test,—only that small changes in the rubber art are important (Br. 37).

Also petitioner in the previous section on "The Tests of Invention Applied by the Circuit Court of Appeals" (Br. 23) quotes from *O'Reilly, et al. v. Morse, et al.*, 15 How. 62 (Br. 24) but that decision is relied upon only as indicative of a "negative test" such as petitioner condemns (Br. 24).

In fact, respondent fails to find in petitioner's brief any statement, other than the "would have constructed" suggestion on page 25, of what tests petitioner considers "established" and would have applied.

Petitioner does on pages 37, 38 and 39 summarize what it calls "facts showing the presence of invention" (Br. 37) and with respect to which it asserts on page 41 that "This Court and the several Circuits Court of Appeals have always considered such evidence to be impelling evidence that the discovery is patentable." Presumably these so-called "facts" are intended to represent "established tests."

Assuming that they are so intended and that they are what petitioner also refers to as "established objective rules" on page 29 of its brief, it cannot even be correctly said, that "the opinion of the Court is *silent* with respect to the established objective rules of invention" as petitioner contends in its brief (Br. 19). It specifically considered commercial success (R. 470) which is included in petitioner's brief (second paragraph on page 41) as one of the so-called "facts" (Br. 37) or "objective tests" which petitioner contends that the Court of Appeals should have but did not apply.

Commercial success is undoubtedly the most important and impelling of petitioner's so-called "objective rules." Without it petitioner's other so-called objective rules undoubtedly would have no persuasive effect. Certainly they would not if prior art is to be disregarded, as petitioner contends (Br. 34), when it lacks commercial success. Commercial success is not in fact an "established test" of invention but only persuasive evidence of invention when the question of invention is in doubt (*McClain v. Ortmyer, supra*). Moreover, the Court of Appeals found that there is no commercial success here (R. 470).



The Court of Appeals, therefore, did in fact consider the invention of the patent in suit objectively in so far as any of petitioner's so-called "objective rules" or tests could be persuasive. Thus, petitioner's entire contention with respect to objective tests fails on this account and also because its proposed objective tests are, in fact, not as represented, namely, "established."

### CONCLUSION.

For the foregoing reasons, respondents respectfully submit that the writ of certiorari should be denied to petitioner as to each and all of petitioner's presented questions.

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Dated Chicago, Illinois,

September 8, 1945.



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CHARLES ELMORE GROPLEY  
CLERK

IN THE  
**SUPREME COURT OF THE UNITED STATES**

OCTOBER TERM, 1945

**No. 330**

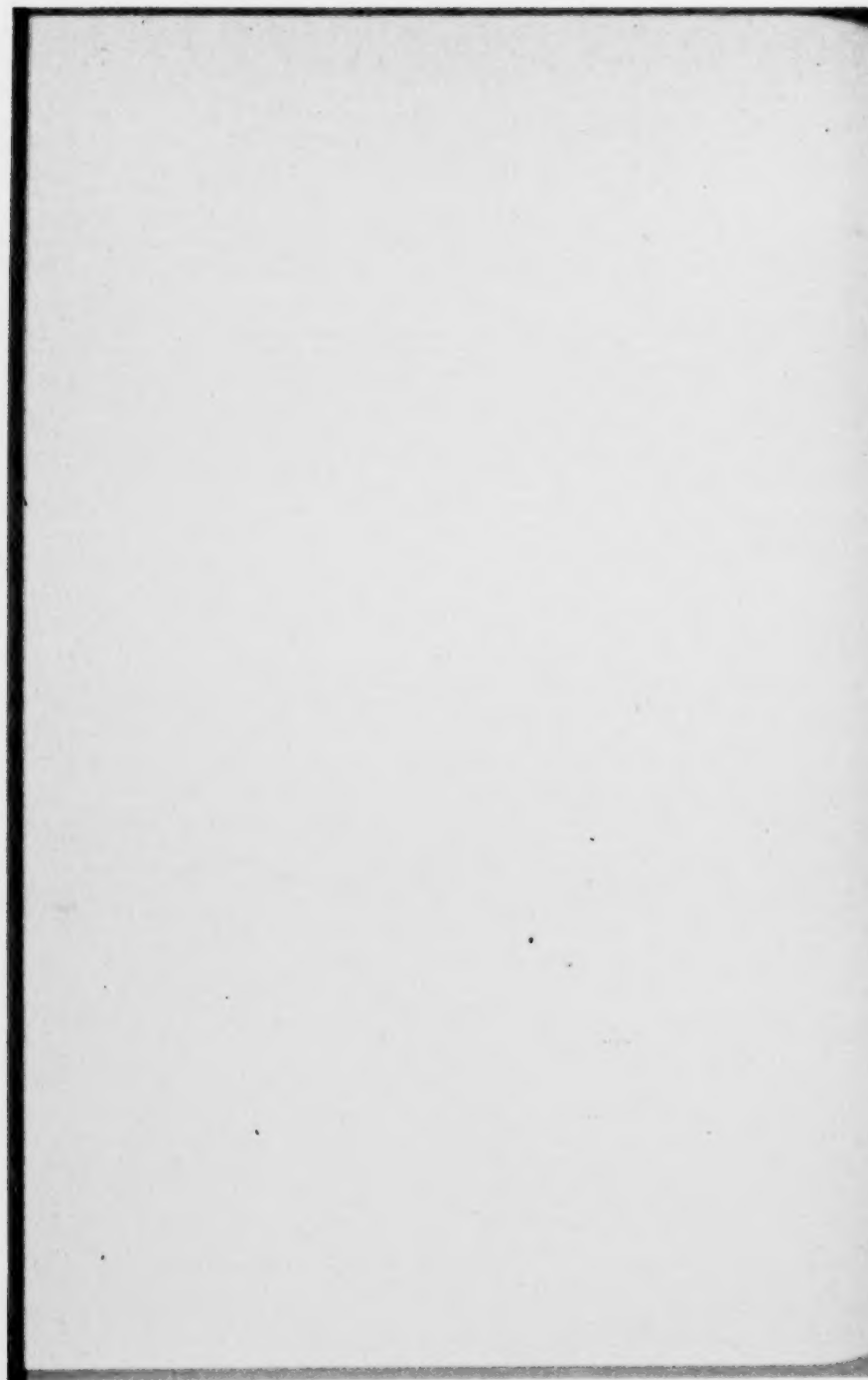
JAMES W. WABER,  
*Petitioner,*  
vs.

MONTGOMERY WARD & CO. INCORPORATED, AND  
UNITED STATES RUBBER COMPANY,  
*Respondents.*

**REPLY OF PETITIONER TO BRIEF OF  
RESPONDENTS IN OPPOSITION TO  
PETITION FOR CERTIORARI.**

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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1945

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**No. 330**

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**JAMES W. WABER,** *Petitioner,*

VS.

**MONTGOMERY WARD & CO. INCORPORATED, AND  
UNITED STATES RUBBER COMPANY,** *Respondents.*

---

**REPLY OF PETITIONER TO BRIEF OF  
RESPONDENTS IN OPPOSITION TO  
PETITION FOR CERTIORARI.**

---

*To the Honorable, the Chief Justice and the Associate  
Justices of the Supreme Court of the United States:*

The respondents' brief has side-stepped the real issues raised in the petition. Specifically the respondents have not taken issue with and have thereby admitted that Waber has given the art at least **three contributions which are not found in any prior art patent** (Pet. 38).\*

First, Waber taught that the base tube must be "slightly smaller" than the cavity of the tire casing; second, that "plastic sealing compound" should be applied to an endless base tube which is used as an air mandrel; and third,

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\*Pet. as used hereafter refers to the Petition for the Writ of Certiorari and Brief in support thereof; Res. Br. refers to Brief of Respondents in opposition to Petition; and Reply refers to this Reply.

the complete combination of all four steps which are necessary for a successful tube with full details for each step (See Pet. 38).

There is no specific finding by either Court that the above three features are found in any of the prior art. The respondents have offered not a single word asserting that there is evidence in this record that the above features are found in any of the prior art.

Failure to lock horns on these important facts renders the Circuit Court's observation\* of anticipation meaningless, for it is an admission by respondents that there is no evidence to support a finding of anticipation. Lacking anticipation, the soundness of the Circuit Court's "could have duplicated" test of invention governs the ultimate disposition of the petition on the merits.

The respondents have woven a superficial argument on the grounds that there are alleged inaccuracies and omissions in the petition (Res. Br. pages 1-4); that a patentee is not entitled to the benefit of the unlikelihood of "a conflict of decisions" rule (Part I, Res. Br. 6-8); that the "could have duplicated" test of invention is sound (Part II, Res. Br. 8-11); that this Court will not consider the alleged anticipation by the Wallace and Wildman patents (Points III and IV, Res. Br. 12-15); that the prior art patents are not abandoned "paper" patents (Part V, Section A, Res. Br. 16-17) and that objective tests of invention are not established by the Courts (Part V, Section B, Res. Br. 17-19).

The Reply follows the order of presentation established in the Respondents' Opposition Brief and demonstrates

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\*The trial Court did not make a positive finding of anticipation. It stated that the patent "is either anticipated \* \* \* or it fails to disclose invention." (Finding 23, R. 337).

that not a single one of these contentions is supported by the record or by the law.

The allegations of inaccuracy and omissions (Res. Br.1-4) are both unfair and unwarranted. Being unsupported by the record and unrelated to the merits of the controversy, they are a strong admission of weakness by the respondents.

The petitioner's statement that "the Circuit Court of Appeals found only three (of the prior art patents) to be pertinent" (Res. Br. 1) is accurate and consistent with the Court's statement that the three patents were "the most pertinent." The opinion (R. 464-471) mentions not a single prior art patent other than the Wallace, Crombie or Wildman patent. Manifestly, the maxim *expressio unius est exclusio alterius* (25 C. J. pages 220-223; 35 C. J. S. pages 283-284) applies.

The allegation of inaccuracy of the statement that the Court "found that two of the four (Waber) steps were not disclosed in Wallace" (Res. Br. 2) is a result of respondent's failure to distinguish between facts and conclusions. The opinion correctly found, with respect to the base tube, that Wallace "does not explain its relative size and shape" (R. 467). Step (1) of the claim requires a base tube "whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used" (R. 466). Thus, the Court found it to be a fact that one step of Waber was not disclosed in Wallace. The Court also found that a "difference between the two processes is the nature of the intermediate layer" (R. 468). Thus, the Court found that a second step (Step 2, R. 466-7) was not disclosed in Wallace. The petitioner's statement of the Court's findings is accurate although it is not consistent with the ultimate conclusion of the Circuit Court of Appeals. In the face of the Court's findings of the foregoing evidentiary facts, its conclusions "Up to this point, the two processes are sub-

stantially, if not precisely, the same" (R. 467); "the only difference" (R. 468); and "Waber's claim to invention over Wallace must rest **solely** on his substitution of a layer of plastic sealing compound for Wallace's layer of puncture-resistant material" (R. 468) are inconsistent with its own fact observations. "Where findings of fact are so inconsistent that it is impossible to harmonize them, it is the duty of the appellate court to accept those which are most favorable to the appellant" (3 Am. Jur. page 463, Appeal and Error, Sec. 898).

That the Court "ignores that the dimensions of the base tube of 'Waber are slightly smaller than the cavity in the tire casing in which said tube is intended to be used'" (Res. Br. 2) is proved by the paragraph above wherein it is shown that the conclusions of the Court disregard the size and shape of the bare tube.

The sophomoric observation of inaccuracy with respect to "*specifically states*" (Res. Br. 2) is based upon respondents' preference for "*specifically quotes*". The distinction is more apparent than real.

The respondents' argument (Res. Br. 2-3) that the Court considered the question of size and concluded that size could not be a feature of the invention necessarily contemplates an unsupported intermediate premise that the "*desired size*" (Res. Br. 3) is "slightly smaller" than the ultimate tire casing (Res. Br. 2; Claim 2, Step (1), Opinion, R. 466). There is no evidence that anyone other than Waber knew or discovered that the "desired size" of a base tube of a puncture resistant tube is "slightly smaller" than the ultimate casing. Indeed, the Court did not so find. Thus, the respondents' argument is unsupported by the record or by the opinion of the Circuit Court of Appeals.

That the conclusion of anticipation is based upon the "not entirely clear" language of the Wildman patent and

upon the "assuming" by the Circuit Court of Appeals (Res. Br. 3-4) may not be gainsaid. The language cited by the Court and by the respondents in their brief is a resume of the method of "molding the tube in the way described herein" (Appendix B, Pet. 45). "The way described herein" demonstrates that the Wildman method is not the Waber method (See Appendix B, Pet. 43-45; column 6, Second Method, Appendix A, Pet. 42A). Not only did Wildman contemplate "**in the main**" building on a straight mandrel; but, further, that was the only way he contemplated. There is not one word in the Court's opinion or in the record that Wildman contemplated "forming an **endless** tube of vulcanizable rubber **whose dimensions are slightly smaller than the cavity in the tire casing in which said tube is intended to be used.**" (Step (1), Claim 2, R. 466). Neither the specification nor the opinion of the court indicate that Wildman discloses an **endless** base tube or that he describes **its relative size and shape**. Of course, the language is not entirely clear and the Court was required to rely upon assumption to make out anticipation.

Part I of the respondents' brief (Res. Br. 6-8) argues that the necessary Certiorari requirements are lacking because the rule that unlikelihood of "a conflict of decision resulting from litigation elsewhere" (Res. Br. 6) is applicable only "where the patent was sustained" whereby "the entire industry was subject to domination" (Res. Br. 6-7).

The Court should be as concerned with a patentee who is unable to meet the resulting conflict rule as with an infringer who is unable to do so. The patentee at least, is a law abider, whereas the infringer is a law violator. The Court should be as jealous of an industry which dominates an inventor as it is of an inventor who dominates an industry.

The rule suggested by respondents lacks completely any mutuality or impartiality. The law does not favor one way streets.

At page eight (8), the respondents seek to create the impression that the petitioner seeks a review of facts. This is not so. The "most pertinent" evidence before the Courts below comprised the Wallace, Crombie and Wildman patents. There was no oral testimony of prior uses. The question of anticipation is but a simple matter of comparing the evidence, that is, comparing the disclosures of the documents themselves to determine whether the prior art patents are for the same invention as the Waber patent. This Court does determine for itself by an examination of patent disclosures whether they are for the same or for different inventions. An example (with respect to identity between an original and a reissue patent) is the recent case of *U. S. Industrial Chemicals, Inc. vs. Carbide & Carbon Chemicals Corp.* (1942) 315 U. S. 668, 678. It is a familiar rule of appellate practice that where the evidence is wholly documentary the rule as to the conclusiveness of findings is not strictly applied as it is in cases where the evidence is principally oral testimony (3 Am. Jur. 473, Appeal and Error Sec. 906; 5 C. J. S. 751, Appeal and Error Sec. 1660; 4 C. J. 889, Appeal and Error Sec. 2859). Moreover, oral testimony is inadmissible to enlarge the scope of letters patent. *U. S. Industrial Chemicals, Inc. vs. Carbide & Carbon Chemicals Corp.* (1942) 315 U. S. 668, 678; *Collar Co. vs. Van Dusen* (1874) 23 Wall. (90 U. S.) 530, 557; *Corning vs. Burden* (1853) 15 How. (56 U. S.) 252, 270.

Respondents' statement that "the lower Courts' findings herein are concurrent" (Res. Br. 8) is inaccurate as is shown by the following:

With respect to the Wallace patent, the Trial Court's opinion was that Wallace was "in point" (R. 331) although

its finding of fact, prepared by respondents, recites that Wallace discloses **"everything"** of Waber except the substitution of the intermediate layer (Finding 20, R. 337). The Circuit Court of Appeals on the contrary found that Wallace did not explain the **"relative size and shape"** of the base tube (R. 467). Thus with respect to Wallace, the findings are not concurrent; indeed, they are opposite.

With respect to Crombie, the apparent concurrence (Trial Court Finding 19, R. 336; Circuit Court Opinion R. 468) is immaterial because neither court found that Crombie anticipated Waber.

With respect to Wildman, the Trial Court found that Wildman disclosed everything of Waber—**"everything, plus two plies of stiff rubber."** (Decision, R. 330; Finding 17, R. 336). The Circuit Court of Appeals quoted this language (R. 469), but did not express agreement. On the contrary, it found the language of Wildman not entirely clear and assumed that Wildman disclosed a process by which the tube **"could be constructed"** (R. 469). Again, there is no concurrence of opinion with respect to the disclosures of the prior art device.

The Courts below did not even concur as to the conclusions to be drawn from the prior art. The trial Court found that **"the patent in suit is either anticipated by the prior art . . . or it failed to disclose invention over such prior art"** (Finding 23, R. 337); whereas, the Circuit Court of Appeals reached the positive conclusion that **"Waber is anticipated by Wallace"** (R. 468); that **"Waber is also anticipated by Wildman"** (R. 469-470); and that **"even though it be assumed, however, that Waber is not anticipated by either Wallace or Wildman, we are still of the view that Waber's disclosure did not amount to invention over this prior art"** (R. 470). The trial Court vacillated on the question of anticipation; the Circuit

Court of Appeals was positive. Can this be deemed concurrence?

It is only in the ultimate conclusion that the patent is invalid that we find concurrence between the two opinions (Conclusion 9 a, R. 337; see also R. 471).

Further, even if the findings by the two lower courts be deemed concurrent, the rule that they are not set aside is subject to definite limitations. *Goodyear Tire & Rubber Co., Inc. et al. vs. Ray-O-Vac Company*, 321 U. S. 275, 278, cited by respondents (Res. Br. 8), refers the reader to *Williams Mfg. Co. vs. United States Shoe Machinery Corp.*, 316 U. S. 364, 367. In the *Williams* case, the rule is stated to be applicable, page 367, "where \* \* \* there is evidence to support them."

Although the cases cited therein arose under the Interstate Commerce Commission Act, this court in *Tagg Bros. v. United States* (1930) 280 U. S. 420, 442 states that an order which rests upon an erroneous rule of law, or is based upon a finding made without evidence, or upon evidence which clearly does not support it must be set aside.

The petition sets forth at length that certain claimed features of Waber are not found in any prior art patents (Pet. 15-18, 29-32, 38 and 42 A). Since the respondents have not answered these assertions of lack of evidence, for the purposes of this petition they have admitted that there is no evidence to support the allegedly concurrent findings upon which they now rely. The rule of concurrent findings does not apply, even if they were here present.

Additionally, the findings signed by the Trial Court do not help this Court because they were prepared by counsel for respondents (R. 331, Pet. 3-4). Some appellate courts



apply the rule that such findings have little weight. *Process Engineers, Inc. vs. Container Corporation of America*, (C. C. A. 7, 1934) 70 F.(2d) 487, 489.

At Page nine (9) the respondents find fault that Representative Jenckes' remarks have no legislative effect upon the construction of the patent statute. Explanations given in Congress are always important in construing and interpreting statutes. *Wright vs. Vinton Branch* (1937) 300 U. S. 440, 459; *Addison vs. Holly Hill Fruit Products* (1944) 322 U. S. 607, 615. The remarks of a Representative in charge of a measure have the legislative effect of informing the Court what the statute means.

The report of the National Patent Planning Commission is not cited for its legislative effect, but it demonstrates that even at this late date, the Circuit Court of Appeals had no sound reason of public policy for failing to heed the expressed intention of the legislature. Congress intended the criterion to be the practical effect of the contribution on the arts. The Court of Appeals had no authority to "rewrite the statute", *Electric Storage Battery Co. vs. Shimadzu, et al.* (1939) 307 U. S. 5, 14.

*Hotchkiss, et al. vs. Greenwood, et al.* (1850) 11 How. (52 U. S.) 248, (Res. Br. 10, 11) is no authority for the "could have duplicated" test of invention. The quoted language (Res. Br. 10) appears in the dissenting opinion and not in the majority opinion. The instructions (pages 264-265) clearly are not subject to the "could have made or devised" interpretation. Apparently, the majority was of the opinion that the instructions were not "virtually" (Page 268), as stated by Mr. Justice Woodbury, a could have duplicated test of invention.

This Court has cited the *Hotchkiss* case a total of twenty times. (Shephard's United States Citations). Not once in those twenty times has this Court expressed the *Hotchkiss*

test of invention as a "could have duplicated" test; on the contrary, the *Hotchkiss* case has been cited as support for the "would have constructed" test advocated by the petitioner (Pet. 25) and condemned by the respondents as an effort "to persuade this Court" (Res. Br. 9).

In *Slawson vs. Grand Street R. R. Co.* (1882) 107 U. S. 649, at Page 653, this Court cited the *Hotchkiss* case to support the negative test that "it would occur to any mechanic \* \* \*".

The respondents have misread *McClain vs. Ortmyer* (1891) 141 U. S. 419 (Res. Br. 10-12). The *McClain* case indicates that the act of invention is between "the production of something new and useful" (page 426) and "an operation of the intellect, \* \* \* a product of intuition or of something akin to genius" (pages 426-427). Its holding is that practical contribution to the art is insufficient in the absence of "some new and important function" of an element "not performed by it in the prior patent" (page 429). The *McClain* case is inapplicable because Waber has both practical contribution and novelty.

The *McClain* case has been cited by the Supreme Court seven times but only once upon the question of practical contributions to the art. In *Dow Co. vs. Halliburton Co.* (1945) 324 U. S. 320, 330, the Court indicated that practical contributions are relevant "but \* \* \* only in a close case where all other proof leaves the question of invention in doubt". All other proof in the instant case comprises the Wallace, Crombie and Wildman patents. The respondents, by their silence, admit that this art does not disclose three of the important contributions made by Waber -(Pet. 38; Reply 1-2 above). Thus, the respondents' principal authority supports the petition.

Moreover, this Court has cited the *McClain* case at least four times in support of the doctrine "*ut res magis valeat quam pereat*" (that the thing may prevail rather than be

destroyed),<sup>1</sup> and twice to support the proposition that all elements of a claim are important.<sup>2</sup> Both of these doctrines support the Petition for Certiorari.

Respondents' Part III (Res. Br. 12) is directed to the Wallace patent with an initial observation that the Appeals Court "in fact, found that Wallace disclosed all the four steps of Waber". The fallacy of this conclusion has already been established above (Reply 3-4, above). The respondents have not met the point (Pet. 30-31) that all elements of a claim must be regarded as material on the question of anticipation.

Part IV (Res. Br. 12-15) is a re-hash of the "assuming" of the Circuit Court of Appeals and the "not entirely clear" language of the Wildman patent. The accuracy of petitioner's analysis of this patent and the opinion has been discussed above (Reply 4-5, above). Further, a consideration of the opinion (R. 468-470), the Waber patent (R. 352), the Wildman patent (R. 428), and the cancelled portions of the file wrapper (Appendix B, Pet. 43-45), referred to by the petitioner to construe the "not entirely clear" language demonstrates the unsoundness of the respondents opposition argument. Respondents have not met the point (Pet. 32-33) that vague and general representations do not support the defense of anticipation.

At page thirteen (13), the respondents refer to construction in the light of the prior art and the lack of necessity to explain what is already known. If the features of Waber allegedly disclosed by Wildman were already known in the prior art, then it would have been unnecessary for the Court to refer to unclear language and assuming; it could have referred to that prior art from whence the knowledge came.

<sup>1</sup>*Coupe vs. Royer* (1895) 155 U. S. 565, 577; *Eibel Co. vs. Paper Co.* (1923) 261 U. S. 45, 63; *Temco Co. vs. Apco Co.* (1928) 275 U. S. 319, 330; *Smith vs. Snow et al.* (1935) 294 U. S. 1, 14.

<sup>2</sup>*Cimiotti Unhairing Co. vs. American Fur Refining Co.* (1905) 198 U. S. 399, 410; *General Pictures Co. vs. Electric Co.* (1938) 304 U. S. 175, 189.

Pages sixteen (16) and seventeen (17) do not deny the fact that the prior art patents are, in truth, "paper" patents, although they do deny technical abandonment. A "paper" patent is an impractical patent which has not been put to successful use. Of what moment is the absence of an actual intent to abandon to the patent's contribution to the art if the patent never went into use?

Respondents attempt to distinguish the Supreme Court decisions cited by petitioner (Pet. 34-35) on the ground that they involve "*the patent in suit in that case*". In any case, the question is one of the broadness of construction to which the patent is entitled. Obviously a "paper" patent should have as narrow a range of anticipation equivalency as of infringement equivalency. The opinions cited by the petitioner hold that a patent which successfully accomplishes the desired end is not anticipated by one which fails to do it (Pet. 35-37).

Respondents' observation that the petitioner "does not even venture to draw any deduction from the cited cases" (Res. Br. 16) is rebutted by the deduction that a "paper" patent is entitled to but a narrow construction at all times, whether it be the patent in suit or it be a prior art patent. In each case its affect and teaching upon the art is negligible.

At pages seventeen (17) to nineteen (19), the respondents find fault that the petitioner has not cited any supporting decisions. This Court throughout the years has decided patentability upon established objective tests. Petitioner's reasons for not citing decisions are two-fold. First, the presence and application of objective tests is something which properly should be delayed until it is learned whether or not Certiorari will be allowed. This, because the presence or absence affects not one whit the petitioner's right to the Writ. Secondly, both the Court

and the respondents are familiar with the decisions involving objective tests of invention.

For information solely, that the Court and the respondents may be advised as to some of the cases upon which petitioner will rely if the petition be granted, the petitioner cites the following list of authorities as enunciating established objective tests of invention: *Goodyear Tire & Rubber Co. vs. Ray-O-Vac Co.* (1944) 321 U. S. 275, 276, 278, 279; *Smith vs. Snow* (1935) 294 U. S. 1; *Minerals Separation, Ltd. vs. Hyde* (1916) 242 U. S. 261, 270; *Diamond Rubber Co. vs. Consolidated Tire Co.* (1911) 220 U. S. 428, 440, 441; *Expanded Metal Company vs. Bradford* (1909) 214 U. S. 366, 381; *Carnegie Steel Co. vs. Cambria Iron Co.* (1902) 185 U. S. 403, 445; *Krementz vs. S. Cottle Co.* (1893) 148 U. S. 556, 560; *Barbed Wire Patent* (1892) 143 U. S. 275, 283; *Loom Company vs. Higgins* (1881) 15 Otto (105 U. S.) 580, 591; *Smith vs. Goodyear Vulcanite Co.* (1876) 3 Otto (93 U. S.) 486, 494; *Rubber Company vs. Goodyear* (1869) 9 Wall. (76 U. S.) 788, 793; *Steiner Sales Co. vs. Schwartz Sales Co.* (C. C. A. 10, 1938) 98 F. (2d) 999, 1003; *McKee, et al, vs. Graton & Knight Co.* (C. C. A. 4, 1937) 87 F. (2d) 262, 264; *Hoeltke vs. C. M. Kemp Mfg. Co.* (C. C. A. 4, 1935) 80 F. (2d) 912, 919; *Trico Products Corporation vs. Apco-Mossberg Corp.* (C. C. A. 1, 1930) 45 F. (2d) 594, 598; *Frick Co. vs. Lindsay* (C. C. A. 4, 1928) 27 F. (2d) 59, 61; *Inland Mfg. Co. vs. American Wood Rim Co.*, (C. C. A. 6, 1926) 14 F (2d) 657, 659; *Kurtz, et al vs. Belle Hat Lining Co., Inc.* (C. C. A. 2, 1922) 280 Fed. 277, 281.

The respondents must well be aware that the facts recited in the Petition, pages 37-42, have, for more than 75 years, strengthened the normal presumption of validity of Letters Patent issued after an examination by the Patent Office; by their silence, they admit the presence of the objective facts referred to in the Petition.

One exception, and one only, appears; that is that the Respondents observed that "the Court of Appeals found that there is no commercial success here (R. 470)" (Res. Br. 18). The Court found that "During the peak year of 1940, something like 100,000 Waber tubes were sold"; and "True, the record discloses some large business concerns which used plaintiff's tubes and found them satisfactory" (R. 470). **This is commercial success.** But in view of sales of 35 to 40 million ordinary inner tubes sold annually, the Court merely viewed it as "far less impressive" than asserted by the Petitioner. Had the sales of prior art *puncture sealing tubes* been several million, its observation would have some merit. But its finding of sales of 100,000, if properly compared with a record showing no sales of prior art tubes, is in truth a finding of vast commercial success. The correct comparison is 100,000 to zero, not 100,000 to several million. A comparison with an improper control teaches the observer nothing.

In his supporting brief, the Petitioner spelled out the failure of the Circuit Court of Appeals to select the proper standard of comparison (Pet. 19). The Respondents remain silent upon this issue.

### CONCLUSION.

In conclusion, the petitioner submits:

- 1) that respondents have failed to meet any of the issues raised by the petitioner, or any of the points relied upon by him;
- 2) that the respondents, by silence, admit the fact that Waber made three contributions to the art;
- 3) that the respondents' accusations of inaccuracy and omissions are unwarranted;
- 4) that the opinions and findings by the courts below have no controlling effect upon this Court in deciding

the question of patentability, (a) because the "prior art" evidence is wholly documentary, (b) because the opinions and findings are not concurrent on questions of fact, (c) because the opinion of the Circuit Court of Appeals is inconsistent *inter se*, (d) because the findings of the Trial Court were prepared by counsel for respondents, and (e) because there is no evidence to support the conclusions of anticipation or lack of invention;

5) that a patentee should have the benefit of the unlikelihood of a conflict of decisions rule to at least the same extent as an infringer;

6) that this Court should render an opinion on the revolutionary "could have duplicated" test of invention adopted by the Circuit Court of Appeals;

7) that this Court should render an opinion on the effect of unsuccessful or "paper" patents as prior art;

8) that this Court should render an opinion as to whether a patent may be anticipated by prior art patents which do not disclose several **claimed features** of the patent in suit; and

9) that this Court should render an opinion as to whether patentability, assuming novelty, should be determined subjectively or whether it should be determined objectively by its practical contributions to the art.

Petitioner therefore renews his earnest request that a writ of *certiorari* be granted for the reasons specified in the petition.

Respectfully submitted,

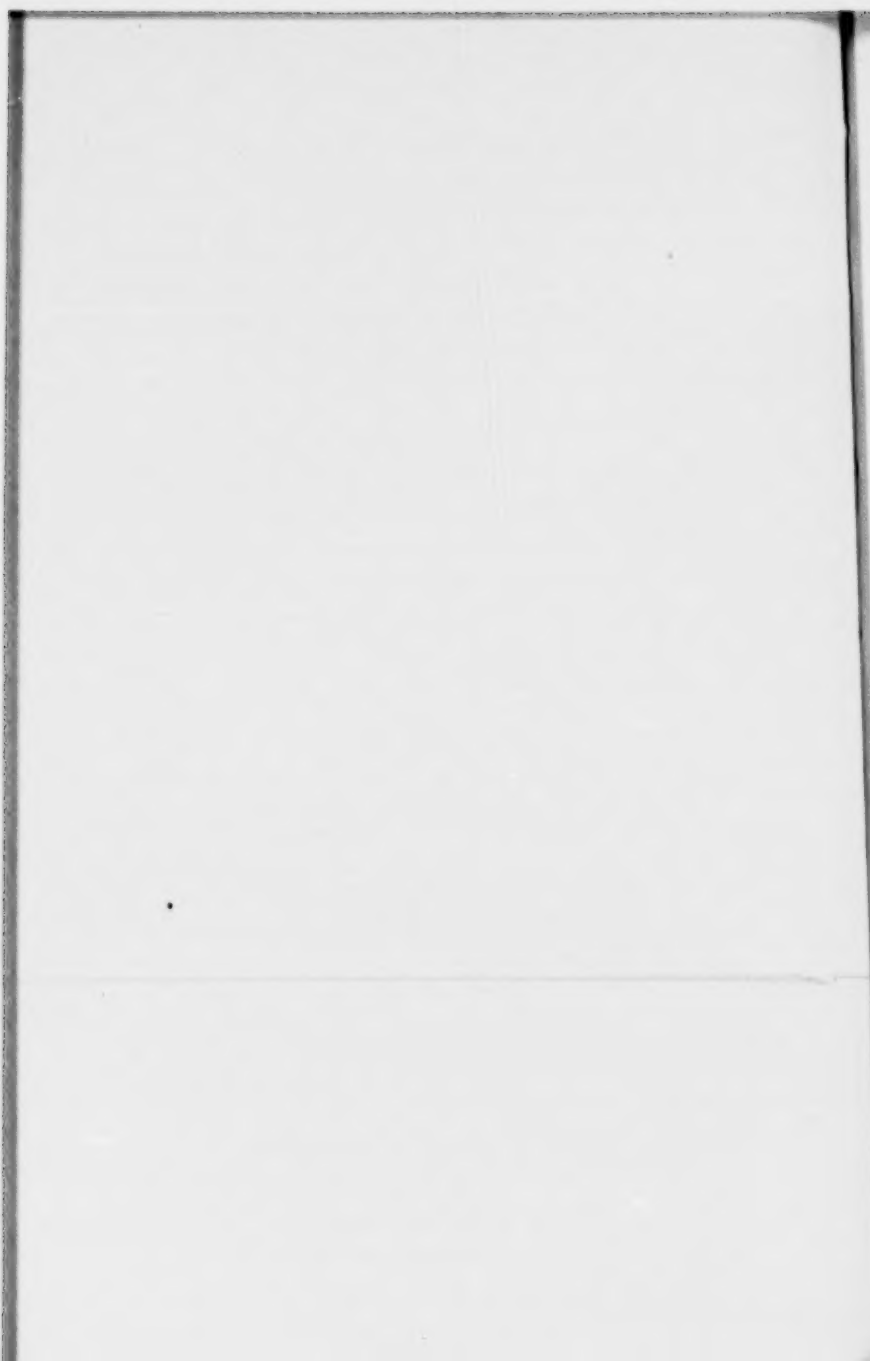
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September 26, 1945.





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FILED

OCT 18 1945

CHARLES ELMORE OROPLEY  
CLERK

IN THE  
**SUPREME COURT OF THE UNITED STATES**

October Term, 1945

**NO. 330**

JAMES W. WABER,

*Petitioner,*

vs.

MONTGOMERY WARD & CO.  
INCORPORATED, AND  
UNITED STATES RUBBER  
COMPANY,

*Respondents.*

On Petition for Writ of  
Certiorari to the United  
States Circuit Court of  
Appeals for the Seventh  
Circuit.

**PETITION FOR REHEARING**

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**PETITION FOR REHEARING**

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James W. Waber respectfully requests the Court to rehear his petition for the writ of certiorari, filed on August 17, 1945, and denied by the Court on October 8, 1945. This petition for rehearing is filed within the 25 day period provided by Rule 33, Rules of this Court.

The petition for the writ of certiorari urged principally that the Circuit Court of Appeals was not justified in striking down letters patent upon the negative test that

“a person trained and skilled in the making of tubes, by studying and understanding this prior art, could have duplicated the accomplishment of Waber” (R. 470).

The petitioner sincerely believes that the “could have duplicated” test of invention should be stricken from the

books and has made further search of the authorities with respect to this unsound and unauthorized test. It is now observed that the test is in direct conflict with a prior holding of this Court on the identical issue, and that the opinion of the Circuit Court of Appeals is therefore untenable.

The "could have duplicated" test was seriously debated in *The Telephone Cases* (1888) 126 U. S. 1. That this Court carefully considered the issues is manifest. The argument continued for twelve days; the Court required 147 pages to discuss the facts (126 U. S. 3-149); the arguments of counsel are reported at length (126 U. S. 149-531); and the 43 page opinion analyzes each of the points raised in argument (126 U. S. 531-573).

The defendants urged that the Bell telephone patents were invalid in view of the prior invention of Philipp Reis, among others. The Reis apparatus could be made to perform exactly like that of Bell either (as defendants asserted) by merely adjusting a set-screw and springs with which the apparatus was provided (126 U. S. 192) or (as plaintiff admitted) by making a slight physical change in the mechanism (126 U. S. 289).

The defendants argued that the Reis method "*will necessarily become familiar to any skilled person studying the operation of that apparatus*" and that the Reis current "*was capable of being made similar*" to that of Bell (126 U. S. 152). It was also urged that the apparatus of one of the defendants was "*precisely that method which any skilled person must necessarily have become cognizant of from a study of the Reis apparatus*" (126 U. S. 154). It was even admitted by the plaintiff that Bell found a clue to his telephone in the Reis instrument (126 U. S. 297).

This therefore was a situation where "a person trained and skilled in the making of (telegraphs), by studying and

understanding this prior art, could have duplicated the accomplishment of (Bell)" (Compare R. 470). The evidence supporting the application of the "could have duplicated" test was clear. The test was suggested in equivalent language. If the test had been sound, the Bell patents would have been invalidated. But the Court refused to sanction such a test of invention.

At page 539, 126 U. S., this Court said:

"We come now to consider the alleged anticipation of Philipp Reis. And here it is to be always kept in mind that **the question is, not whether the apparatus devised by Reis to give effect to his theory can be made, with our present knowledge, to transmit speech, but whether Reis had in his time found out the way of using it successfully for that purpose;** not as to the character of the apparatus, but as to the mode of treating the current of electricity on which the apparatus is to act, so as to make that current a medium for receiving the vibrations of air created by the human voice in articulate speech at one place, and in effect delivering them at the ear of a listener in another place. Bell's patent is not alone for the particular apparatus he describes, but for the process that apparatus was designed to bring into use. **His patent would be quite as good if he had actually used Reis's apparatus in developing the process for which it was granted.**"

At page 545, the opinion continued:

"Reis never thought of it, and he failed to transmit speech telegraphically. Bell did, and he succeeded. Under such circumstances it is impossible to hold that what Reis did was an anticipation of the discovery of Bell. To follow Reis is to fail, but to follow Bell is to succeed. The difference between the two is just the difference between failure and success. **If Reis had kept on he might have found out the way to succeed, but he stopped and failed.** Bell took up his work and carried it on to a successful result."

The foregoing direct denunciation by this Court of the "could have duplicated" test of invention fully justifies the issuance of the writ of certiorari. The petitioner has no other opportunity to obtain review of the erroneous decisions of the lower courts for the reason that a resulting conflict of decisions directly affecting the patent is improbable (Pet'n. 21-23).

The opinion of the Circuit Court of Appeals uses language positively indicating that its analysis of the prior art and its evaluation of the Waber patent are based upon the "could have" philosophy of mere possibilities and conjecture. Such phrases as: "As we understand" (R. 467); "It must be assumed" (R. 467); "so we think" (R. 467); the Wallace prior art "does not explain" (R. 467); "substantially, if not precisely" (R. 467); "We see no substantial difference" (R. 468); "While this language is not entirely clear" (R. 469); "we are inclined to agree" (R. 469); "Assuming, as we think we must" (R. 469); "could be constructed" (R. 469); "we are of the view" (R. 469); "At any rate, we think" (R. 470); and "could have duplicated" (R. 470) would not have been used by the Circuit Court of Appeals had there been a teaching of the Waber method by the prior art. Such understandings, assumptions, lack of explanation, lack of preciseness, seeings, unclear language, inclinations, views, thoughts, opinions and possibilities are not evidence. They are insufficient to overcome the normal presumption of validity of letters patent issued after an examination by the patent office.

Waber taught the public how, for the first time, to make a successful puncture sealing inner tube. It is important that there is **no evidence** in this record that anyone else could have done so. Certainly no one did. The Court merely said "we are of the opinion" (R. 470) that someone else

could have duplicated Waber, but it pointed to no supporting evidence.

The petitioner argues that the "could have duplicated" test is unjustified because it is contrary to the patent statutes, construed as the Congress intended (Pet'n. 26-27); that it constitutes judicial legislation by the Circuit Court of Appeals (Pet'n. 27-28); that it is in conflict in principle with the decision of this Court in *O'Reilly et al vs. Morse et al* (1853) 15 How. (56 U. S.) 62, 111 (Pet'n. 24-25); and that it is contrary to the public policy of this country as expressed in the detailed report of the late President Roosevelt's National Patent Planning Commission (Pet'n. 27). These grounds are now strengthened by the opinion in *The Telephone Cases*, 126 U. S. 1.

The respondents argue that the "could have duplicated" test is justified in view of the dissenting opinion of Justice Woodbury in *Hotchkiss et al vs. Greenwood et al* (1850) 11 How. (52 U. S.) 248, 268 (Res. Br. 10). The respondents, however, make no attempt to justify the test on statutory grounds or on public policy. Any argument based upon respondents' construction of the dissenting opinion of Justice Woodbury is in direct conflict with the subsequent opinion of this Court in *The Telephone Cases*, 126 U. S. 1 and should be disregarded.

Further, the "could have duplicated" test could always be proved where interfering patent applications were filed. The fact that two people made the same invention is positive evidence that the invention could have been duplicated by another because it was. If the "could have duplicated" test were sound would Congress not have provided that the filing of two interfering applications should invalidate both applications in lieu of providing for several detailed interference proceedings (U. S. Code, Title 35, Section 52, 63,

and 66) to determine priority among the independent "duplicators"?"

In conclusion, petitioner requests reconsideration by the Court, and the granting of the writ. The practical consequences of a ruling by a court of last resort that the presence or absence of invention is to be determined by the test as to whether someone else "could have duplicated" the claimed invention are manifest. Under this test, what patent can ever stand?

The world would not have been without the electric light bulb had Edison not lived. Sawyer and Mann were very close. They could have duplicated Edison. Under the test of the Circuit Court of Appeals, the patent on the DeForest audion would not have been sustained, for had one studied the art he "could have duplicated" it. Both DeForest and Edison utilized knowledge that others had, but which no one had utilized.

A test of invention that has in it the possibilities of destruction of the patent system should be frowned on here as in *The Telephone Cases*.

The undersigned attorneys hereby certify that this petition for rehearing is presented in good faith and not for delay as is required by Rule 33, Rules of this Court.

*Respectfully submitted*

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